EXHIBIT E

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION

EOLAS TECHNOLOGIES, INC. Plaintiff, v. ADOBE SYSTEMS, INC. ET AL., Defendants.	CIVIL ACTION NO. 6:09-CV-446 (LED)

EXPERT REPORT OF NICHOLAS P. GODICI

I. INTRODUCTION

1. I, Nicholas P. Godici, have been retained by counsel for Amazon, Inc., eBay, Inc., Yahoo! Inc., Google Inc., YouTube LLC, Adobe Systems Incorporated, The Go-Daddy Group, Inc., Apple Inc., CDW Corporation, J.C. Penney Corporation, and Staples, Inc. as an expert witness in connection with the above-referenced matter. I have been asked to provide expert testimony on rules, practices, and procedures related to the examination of patent applications and the reexamination of patents in the United States Patent and Trademark Office ("USPTO")[1]. I have been asked to review the file histories of the patents-in-suit[2] and explain the actions taken by the PTO and the documents/responses filed by the applicant and/or patent owner during the original prosecution as well and the reexamination of those patents. I have been asked to explain the duty of candor and duty to disclose material information required of patent applicants and their representatives when dealing with the PTO. I have been asked to explain the requirements to prove inequitable conduct. I have also been asked to opine on the application of PTO rules, practices, and procedures to the evidence in this case particularly with respect to the patents-in-suit.

2. I reserve the right to give opinions on facts and other matters arising subsequent to this report, including rebuttal to any matter raised by the parties or their experts, either prior to or during any hearing or trial in this action.

A. Qualifications.

[1] I may refer to the USPTO as simply the PTO.

[2] U.S. Patent 5,838,906 (" the '906 patent) and U.S. Patent 7,599,985 ("the '985 patent").

3. I am currently the Executive Advisor for the intellectual property law firm of Birch, Stewart, Kolasch & Birch, LLP located in Falls Church, Virginia.

4. I have over 39 years of experience in the patent field and spent my entire career, until my retirement in March 2005, at the USPTO. I served as the Commissioner for Patents at the USPTO from March 2000 to March 2005. I also served as the Acting Undersecretary of Commerce for Intellectual Property and Director of the USPTO from January to December 2001. In 2009, at the request of the Secretary of Commerce, I served as an expert advisor to the Secretary and USPTO Acting Director on management issues, prior to Senate confirmation of the new Under Secretary nominated by the President.

5. I began my career at the USPTO in 1972 as a patent examiner, and held the positions of Supervisory Patent Examiner "SPE", Group Director, Deputy Assistant Commissioner for Patents, and Acting Assistant Commissioner for Patents before being named Commissioner for Patents by the Secretary of Commerce on March 29, 2000. As Commissioner for Patents, I was responsible for all aspects of patent related operations at the USPTO including a budget of over $750 million and a staff of over 5000 employees that included the entire patent examining corps. During my time at the USPTO, I examined approximately 7000 patent applications. I also conducted reexamination proceedings during my career at the PTO.

6. As Acting Undersecretary of Commerce for Intellectual Property and Director of the USPTO, I reported to and advised the Secretary of Commerce on all intellectual property policy matters and was responsible for all operational aspects of the USPTO. I retired from the USPTO in March 2005.

7. I hold a Bachelor of Science degree in Engineering Mechanics from Pennsylvania State University, awarded in 1972, and a Certificate of Advanced Public Management from The Maxwell School of Citizenship and Public Affairs, Syracuse University, in 1999. My curriculum vita (which includes a list of my publications in the last ten years) is attached as **Exhibit A** to this report. I may testify with respect to my responsibilities and experiences relating to the information listed in **Exhibit A**.

B. Prior Testimony

8. A list of cases in which I have testified as an expert at trial or by deposition in the last four years is attached as **Exhibit B**.

C. Materials Considered

9. The list of materials that I have considered in whole or in part in reaching my conclusions is attached as **Exhibit C**. I understand that additional discovery is being conducted in this case, and I reserve the right to supplement and/or modify my analysis and the resulting conclusions if additional relevant information becomes available. At trial, deposition, or in any supplemental report, I may use all or a portion of the documents I considered in preparing this report and possibly other visual aids, charts, or exhibits.

D. Compensation

10. Birch, Stewart, Kolasch & Birch, LLP is being compensated at the rate of $700 per hour for my time in this case. The compensation received from this case is not contingent upon my opinions or performance, the outcome of the case, or any issues involved in or related to the case.

E. Scope of My Opinions

11. At the present time, I expect to testify on (i) the rules, procedural requirements, and duties governing the filing and prosecution of patent applications in the USPTO and the grant of U.S. patents by the USPTO, (ii) the rules, procedural requirements, and duties governing reexamination proceedings in the USPTO, (iii) the duty of candor and good faith and duty to disclose material information that inventors, their attorneys, and others substantively involved in the preparation and prosecution of a patent application and/or reexamination proceeding owe to the USPTO, (iv) the standards required to prove inequitable conduct, and (v) the prosecution histories and reexamination proceedings of the patents-in-suit including explaining the actions taken by the PTO and the actions/responses submitted by the patent applicants and/or patent owner.

12. The opinions stated in this report are based on information currently available to me. I reserve the right to continue my investigation and study, which may include a review of documents, information, and expert reports that may yet be produced, as well as any testimony from depositions for which transcripts are not yet available and that may yet be taken in this case. Therefore, I reserve the right to expand or modify this report as my investigation and study continues, and to supplement my opinions in response to any additional information that becomes available to me, to any matters raised by the parties, and/or other opinions provided by the parties' expert(s). In my testimony I may use exhibits and demonstratives.

II. OVERVIEW OF THE USPTO PATENT EXAMINATION PROCESS AND THE DUTIES OF CANDOR AND DISCLOSURE

A. The Patent Examination Process

13. Article I, Section 8, of the U.S. Constitution gives Congress the right to promote the progress of science and the useful arts by providing inventors exclusive rights to their inventions for a limited time. Pursuant to this authorization, Congress created a patent system and established the USPTO to examine patent applications and grant patents.

14. An applicant for patent in the United States initiates the application process by filing an application with the USPTO detailing the subject matter for which patent protection is sought. The application is required to include a specification including a claim or claims, drawings when necessary, an inventor's oath or declaration, and the required fees.[3]

15. The specification must conclude with a set of one or more claims. The claims point out and distinctly describe the subject matter that the applicant regards as the invention.[4] The claims are an important part of the application because they define the metes and bounds of the protection the applicant is seeking. Courts rely on the scope of the claims to determine whether the patented invention has been infringed. The claims must conform to the invention as set forth in the specification and must find clear support in the specification.

16. The oath or declaration signed by each inventor certifies that the inventor believes that he or she is the original first inventor of the subject matter claimed and for

[3] 35 U.S.C. § 111(a).

[4] 37 CFR § 1.75(a).

which a patent is sought. The inventor also makes various other certifications required by law and various USPTO rules.[5]

17. After a patent application has been filed, administrative staff for the USPTO performs a preliminary review to ensure that the application meets the formal requirements established by Congress and the USPTO. If the application fails to meet the formal requirements, the applicant will be notified of the deficiencies and be given a time period in which to complete the formal requirements of the application.

18. After the review of a patent application for formal matters, the application is assigned to an examiner in a Group Art Unit that is responsible for examining applications in a particular technological area. The examiner is responsible for examining the application and preparing an Office Action stating his/her rationale and conclusions with respect to patentability. In the examination of a patent application, the examiner is required initially to determine whether the claims of the application satisfy the requirements for patentability set forth in the patent statutes and regulations. The claims of a patent application define the invention and the scope of protection the applicant is seeking.

19. The examination of claims in a patent application requires an examiner to conduct a search for "prior art" related to the claimed invention.[6] Prior art may include prior patents (both U.S. patents and foreign patents) and prior non-patent publications

[5] 37 CFR § 1.63.

[6] MPEP 704.01.

(e.g., magazines and trade journals) sometimes called non-patent literature.[7] In addition, prior art may include prior public uses, sales, and offers for sale of the invention.[8]

20. While applicants are not required to conduct a prior art search, they are required to disclose *material* information that they are aware of to the USPTO under their duty of candor. Material information is not limited to published prior art, but embraces *any* information that would be considered material in deciding whether to allow the claims of an application. Such information includes but is not limited to information on enablement, prior public uses, sales or offers for sale, invention by another and/or any other information that would impact the PTO's decision to issue the patent.[9] Many applicants disclose information they are aware of to the PTO via an Information Disclosure Statement (IDS). If an IDS is filed in compliance with PTO regulations,[10] the examiner will consider the prior art references or other information in the IDS during the examination of the application. [11]

21. After analyzing the prior art and any other issues, the examiner issues an Office Action rejecting claims, objecting to claims, or allowing the claims of the application.[12] Claims may be rejected, for example, because they are not novel in light of the prior art or differ only in obvious ways from the existing prior art. Claims may also be

[7] MPEP 901.06.

[8] 35 U.S.C. §102.

[9] MPEP 2001.04.

[10] 37 CFR §§ 1.97 and 1.98.

[11] MPEP 609.

[12] 37 CFR § 1.104.

rejected if the invention was in public use, on sale or offered for sale, or invented by another before the filing date of the application for patent. The references and information relied on by the examiner and the reasons for the rejection are set forth in the Office Action sent to the applicant.

22. An applicant may reply to rejections and objections set forth in an Office Action by filing a reply, sometimes called a response, to the examiner's action. The reply must be reduced to writing and must present arguments pointing out the specific distinctions believed to render the claims patentable over any applied references. The applicant must make a bona fide attempt to advance the application to a final action. Mere allegations that the examiner has erred is not a proper response to an Office Action.[13]

23. Amendments to the specification and/or claims may also be submitted. Any amendments made during the application process must find support in the original specification of the application.[14] If an applicant chooses to amend the claims in response to an Office Action, the applicant must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant must also show how the amendments avoid such references or objections.[15] Since the patent examination process is *ex parte*, that is it takes place only between the patent applicant and the PTO, third party participation is prohibited.

[13] 37 CFR § 1.111(b).

[14] 37 CFR § 1.121(f); MPEP 608.04.

[15] 37 CFR § 1.111(c).

24. The examiner then reviews any amendments and/or arguments submitted by the applicant to determine if the conditions for patentability are met. The examiner can either allow the application or issue a new Office Action if rejections and/or objections remain.[16] If the claims in the application continue to be rejected, normally the examiner's second action is made "final". At that point, the applicant can appeal the decision of the examiner to the USPTO Board of Patent Appeals and Interferences (and ultimately to the Federal courts), file a continuing application or request for continued examination, or abandon the application.

25. If, on the examiner's original examination of the application or after considering the responses and amendments made by the applicant, the patent application is found to be in allowable condition, a Notice of Allowance will be sent to the applicant. A fee for issuing the patent is due within three months from the date of the Notice. Once the issue fee is paid, the application will issue as a patent.

26. By law, all U.S. patents are presumed valid.[17] This is sometimes called the "presumption of validity". However, this presumption of validity may be overcome in litigation by presenting clear and convincing evidence of invalidity.[18] Often, evidence of invalidity presented in a trial includes information not considered by the PTO during the original examination.

B. Reexamination Proceedings in the PTO

[16] 37 CFR § 1.112.

[17] 35 U.S.C. § 282.

[18] *Microsoft Corp. v. i4i L.P. and Infrastructures for Information Inc.*, United States Supreme Court, No. 10-290, decided June 9, 2011.

27. "Reexamination" is a process whereby anyone may request that the PTO reexamine an issued patent to determine if the subject matter claimed is patentable in light of a substantial new question of patentability raised in a request for reexamination.

28. There are two types of reexamination procedures available—*ex parte* and *inter partes*. *Ex parte* reexamination is much like the prosecution of an original patent application in that the proceedings are limited to communications between the PTO and the patent owner. Third party requester participation in the proceedings is not permitted beyond the initial reexamination request.[19] On the other hand, in *inter partes* reexamination, after the requesting party submits its reexamination request, the requester may participate in the proceedings (and any appeals) by filings comments to responses made by the patent owner.[20] While *ex parte* reexamination is available to all patents, *inter partes* reexamination is only available to patents that were filed on or after November 29, 1999.[21]

29. Reexamination proceedings may be initiated by any person filing a reexamination request with the PTO or by the Director of the PTO.[22] To request a reexamination, the requesting party must pay a fee and submit a statement that describes how prior art patents and/or printed publications raise a "substantial new question of patentability" with respect to the claims of the patent.[23] If the PTO agrees that there is a

[19] In limited situations the third party requester may file a one-time response to a patent owner statement filed under 37 CFR 1.530 however very few patent owner's file such a statement.

[20] 37 CFR § 1.947.

[21] MPEP 2611.

[22] 37 CFR §§1.510 and 1.520.

[23] 37 § CFR 1.510.

substantial new question of patentability, then the PTO orders or grants a reexamination. One important difference between reexamination and original examination is that reexamination is *limited by law* to the consideration of prior art patents and printed publications only.[24] During reexamination the PTO may not consider other types of prior art such as prior public uses, sales or offers for sale, and prior invention by another that may be raised and considered during original examination.

30. If a request for reexamination is granted, the PTO's decision granting the request will conclude that a substantial new question of patentability has been raised by (a) identifying all claims and issues, (b) identifying the prior art patents and/or printed publications relied on, and (c) providing a brief statement of the rationale supporting each new question.[25]

31. After the PTO determines that there is a substantial new question of patentability and orders reexamination, the claims of the patent are subjected to another examination similar to the examination conducted during the prosecution of the original patent application that lead to the issuance of the patent. The examiner will issue an Office Action in which the patent claims may be rejected in light of the new questions of patentability raised by the reexamination request. Claims may also be confirmed as patentable if the examiner determines that claims are allowable over the prior art.

32. As in normal patent prosecution, a patent owner may reply to rejections set forth in an Office Action during reexamination by filing a response pointing out what

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[24] 35 U.S.C. §§ 301 and 302.

[25] MPEP 2246.

the patent owner believes are errors in the examiner's Action.[26] The reply must be reduced to writing which distinctly and specifically points out the supposed errors in the examiner's Action and must reply to every ground of rejection. In a reply to a rejection in reexamination, the patent owner may also file an amendment to narrow or cancel the rejected claims. Enlargement of the scope of the claims in reexamination is prohibited.[27] Alternatively, the patent owner may also submit new claims, provided that the new claims are narrower than the rejected claims of the patent. At this stage the *ex parte* reexamination requester may not participate or comment on the proceedings with the patent owner.

33. The patent owner, attorneys that represent patent owners, and other individuals who are substantively involved in the reexamination proceeding on behalf of the patent owner have a duty of disclosure similar to that duty in original examination. [28] Information material to patentability may be submitted in an IDS. However, typically the primary source of prior art considered by the examiner during reexamination will be the patents and printed publications cited in the request for *ex parte* reexamination.[29] If information is submitted under the duty of disclosure during reexamination, PTO procedures state the following:[30]

[26] 37 CFR §1.111.

[27] 37 CFR §1.530.

[28] 37 CFR § 1.555.

[29] MPEP 2256.

[30] *Id.*

> Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above.

34. As with normal patent prosecution, the examiner then reviews any amendments and/or arguments submitted by the patent owner to determine if the conditions for patentability are met. The examiner can either confirm (allow) the claims or issue a new Office Action if rejections remain. If the claims continue to be rejected, normally the examiner's second Action is made final.[31] At that point, the patent owner may appeal the decision of the examiner to the USPTO Board of Patent Appeals and Interferences (and ultimately to the Federal courts).

35. Upon conclusion of the reexamination proceeding the examiner will prepare a "Notice of Intent to Issue *Ex Parte* Reexamination Certificate" (NIRC). The NIRC indicates that the preceding is concluded and sets forth the results of the reexamination with respect to the claims. Reasons for allowance must be given for each claim found patentable. [32]

36. Once the reexamination has concluded (including all available appeals) and the NIRC has been issued, a "certificate of reexamination" is published. The

[31] MPEP 2271.

[32] MPEP 2287.

certificate sets forth the results of the reexamination proceeding and the content of the patent following the reexamination process.[33]

C. The Duty of Candor and Good Faith and the Duty of Disclosure

37. Patent prosecution is an *ex parte* process between the applicants or their attorneys and the PTO examiner. Third party participation is not permitted. As a result, patent applicants, their representatives, and others substantively involved in prosecution of a patent application have a duty of candor and good faith in dealing with the PTO. This duty requires applicants and their representatives to deal candidly and truthfully with the PTO such that the PTO can rely on representations/statements made by applicants and their representatives during the examination process. Additionally, these individuals have a duty to provide information known to be material to patentability of the claims pending in the application. This obligation, which is referred to as the "duty of disclosure" is important to the successful operation of the Patent System. The duty of candor and good faith and the duty of disclosure are set forth in 37 CFR § 1.56(a) which states:

> A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be

[33] 37 CFR § 1.570.

> submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:
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> (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
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> (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.[34]

38. The term "information" in 37 CFR § 1.56 includes any information "material to patentability" including, of course, prior art, but also including information on enablement, possible prior public use, sales, offers to sell, derived knowledge, prior invention by another, inventorship conflicts, and the like, as well as information that is inconsistent with arguments made by the applicant. See MPEP 2001.04.

39. Applicants and their representatives may submit information to the PTO under their duty of disclosure by filing an IDS. If information is disclosed to the PTO in an IDS that complies with 37 CFR 1.97 and 1.98 the examiner will consider that

[34] 37 CFR § 1.56 (a)

information in the same manner as other documents in Office search files are considered by the examiner when while conducting a prior art search.[35]

40. 37 CFR § 1.56(c) states that the following individuals have the duty of disclosure:

> (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
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> (1) Each inventor named in the application;
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> (2) Each attorney or agent who prepares or prosecutes the application; and
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> (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

41. The Federal Circuit recently issued an *en banc* opinion in *Therasense Inc. v. Becton Dickinson and Co*. (Fed. Cir. May 25, 2011), in which issues related to inequitable conduct were considered. I have reviewed the Federal Circuit's opinion. According to *Therasense*, to prevail on an inequitable conduct claim, "the accused infringer must prove by clear and convincing evidence that the applicant knew of the reference, knew that it was material, and made a deliberate decision to withhold it."[36] The Court maintained that materiality and intent are separate elements, but eliminated the "sliding scale" approach that balanced materiality with intent. However, intent may be inferred from indirect and circumstantial evidence. To meet the clear and convincing standard, the specific intent to deceive must be "the single most reasonable inference able

[35] MPEP 609.
[36] *Therasense*, at *32.

to be drawn from the evidence," and the evidence "must be sufficient to *require* a finding of deceitful intent in light of all the circumstances".[37] That is "when there are multiple reasonable inferences that may be drawn, intent to deceive cannot be found."[38] Further, the Court held that materiality is now to be determined using the "but-for" standard, which means the withheld prior art is material only if the PTO would not have allowed a claim if it had been aware of the undisclosed prior art. That determination is made using a preponderance of the evidence standard while giving claims their broadest reasonable construction.[39]

42. I further understand that the Federal Circuit held in *Therasense* that there is an exception to the "but-for" standard of materiality. Where the patentee has engaged in affirmative acts of egregious misconduct, such as the filing of a false affidavit, the misconduct is material.[40] Dishonesty before the PTO is always material, regardless of whether the PTO would have allowed the claim had the patentee been honest.[41]

D. Materiality

43. Prior to the *Therasense* decision the Federal Circuit had recognized multiple standards for materiality. The version of 37 CFR § 1.56 that was in place prior to March 16, 1992, defined the term using the so-called "reasonable examiner" standard, as follows:

[37] *Id. at *34.*
[38] *Id.*

[39] *Id.* at *37.

[40] *Id.* at 29.

[41] *Id.* at 29-30.

> A duty of candor and good faith toward the Patent and Trademark Office rests on the inventor, on each attorney or agent who prepares or prosecutes the application and on every other individual who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application. All such individuals have a duty to disclose to the Office information they are aware of which is material to the examination of the application. Such information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. The duty is commensurate with the degree of involvement in the preparation or prosecution of the application.[42]

44. Effective March 16, 1992, 37 CFR § 1.56 was amended to replace the "reasonable examiner" language previously expressed in the rule with the current definition of "material" information. The current language of 37 CFR § 1.56(b) defines material information as follows:

> (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
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> (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
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> (2) It refutes, or is inconsistent with, a position the applicant takes in:
> (i) Opposing an argument of unpatentability relied on by the Office, or
> (ii) Asserting an argument of patentability.

[42] 37 CFR §1.56 (a) (version prior to March 16, 1992).

> A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.[43]

45. Although the "reasonable examiner" language found in the pre-1992 version of 37 CFR § 1.56 was replaced with the language of the 1992 version of the Rule, the Federal Circuit has in the past held that information may be considered "material" if it would be "material" under either the March 16, 1992 version of 37 CFR § 1.56 or the former "reasonable examiner" standard.[44] Based on my understanding of the *Therasense* decision the Federal Circuit has held that a single standard for materiality now exists when considering inequitable conduct. That standard is the "but-for" standard.

E. Inequitable Conduct

46. To prevail on the defense of inequitable conduct, the accused infringer must prove that the applicant misrepresented or omitted material information with the specific intent to deceive the PTO.[45] In other words, the accused infringer must prove by clear and convincing evidence that the applicant knew of the reference, knew that it was material, and made a deliberate decision to withhold it. [46]

[43] 37 CFR §1.56(b).

[44] *Digital Control Inc. v. Charles Machine Works*, 437 F.3d 1309, 1314 (Fed. Cir. 2006).

[45] *Star Scientific Inc. v. R.J. Reynolds Tobacco Co.* , 537 F.3d 1357, 1365 (Fed. Cir. 2008) cited in *Therasense*.

[46] *Therasense, at *32.*

47. I understand that the clear and convincing evidence standard requires that the trier of fact must be persuaded by the evidence that it is highly probable that the claim or affirmative defense is true. The clear and convincing evidence standard is a heavier burden than the preponderance of the evidence standard but less than the beyond a reasonable doubt standard.

48. To prove intent requires that specific intent to deceive must be "the single most reasonable inference able to be drawn from the evidence".[47] Moreover, a district court must weigh the evidence of intent to deceive independent of its analysis of materiality. [48]

III. SUMMARY OF THE PROSECUTION HISTORY OF THE PATENTS-IN-SUIT

A. The '906 Patent Original Prosecution

49. The application that ultimately issued as the '906 patent was filed on October 17, 1994 and was assigned serial number 08/324,443 ("the '443 application"). The named inventors were Michael D. Doyle, David C. Martin, and Cheong S. Ang. The application was filed by the inventor's representative, Charles J. Kulas. [EOLASTX-0000007083-122]

50. An IDS was filed by Mr. Kulas on November 3, 1994. [EOLASTX-0000007732-33 (statement); EOLASTX-0000007756-58 (listing of cited references).

[47] *Id. at *34.*

[48] *Id. at *33.*

51. On November 18, 1994 the PTO mailed a Notice To File Missing Parts of Application indicating that fees and a signed declaration were missing. On December 2, 1994 Mr. Kulas filed a response to the Notice that included the required fees and declaration signed by the inventors. This declaration, signed by all three named inventors on November 11, 1994, included an acknowledgement of the duty to disclose information which is material to the examination of the application in accordance with 37 CFR § 1.56. [EOLASTX-0000007737]

52. On May 6, 1996 the PTO mailed the first Office Action in the '443 application. Claims 1-4 and 15-16 were rejected as anticipated by The University of Southern California Mercury Project (in public use from Sept. 15, 1994 to March 31, 1995). Claims 1-43 were rejected as unpatentable over the Applicant's disclosed prior art further in view of the Hansen article. The Office Action was signed by Examiner D. Dinh. [EOLASTX-0000007743-753]

53. On August 6, 1996 a response to the outstanding Office Action was filed. The response was signed by Michael E. Woods over the name and registration number of Charles E. Krueger. Claims 1-9, 14, 15, 23, 24, 28, and 34 were amended. Claim 16 was cancelled and claims 44-56 were added. Arguments were included in an attempt to overcome the Examiner's rejections. [EOLASTX-0000007759-7778]

54. On December 13, 1996 the PTO mailed the next Office Action in the '443 application. Claims 1 and 44 were rejected as unpatentable over the Vetter article ("Mosaic") further in view of Hansen. Claims 2-5, 10-14, 24-27, 45-48, and 55 were rejected as unpatentable over Mosaic, Hansen, and Filepp (U.S. patent 5,347,632).

Additional claims were rejected on the above references further in view of the Rizzo and /or Moran publications. This Action was made final. [EOLASTX-0000007780-7792]

55. On January 8, 1997 a response to the final rejection was filed. This response included a declaration under "Rule 131"[49] swearing behind the Mosaic reference. The declaration, signed by inventor Doyle, stated that the claimed subject matter was reduced to practice in this country prior to October 1994. Mr. Krueger argued that since the Rule 131 declaration removed Mosaic as prior art, the outstanding rejections were overcome. [EOLASTX-0000007794-7806]

56. On January 24, 1997 the PTO mailed the next Office Action in the '443 application. Claims 1-5, 10-14, and 44-48 were rejected as unpatentable over HyperNet further in view of Hansen. Additional claims were rejected over this combination of references further in view of Rizzo and Moran. [EOLASTX-0000007821-832]

57. On February 26, 1997 the PTO mailed an Examiner Interview Summary Record, indicating that a personal interview was held on February 24, 1997. The interview was attended by inventor Doyle, his representative, Mr. Krueger and Examiners Lee and Dinh. The Examiner indicated that the HyperNet reference was discussed and that the applicant's arguments were persuasive to overcome the HyperNet reference. [EOLASTX-0000007835]

58. On March 26, 1997 the PTO mailed the next Office Action in the '443 application. Claims 1 and 44 were rejected as unpatentable over a combination of Applicant's disclosed prior art, Khoyi (U.S. patent 5,206,951), and the Hansen

[49] 37 CFR § 1.131.

publication. Additional claims were rejected over this combination further in view of Rizzo and Moran. [EOLASTX-0000007836-847]

59. On June 2, 1997 a response to the outstanding Office Action was filed. Claims 1-5 and 44-48 were amended. Claims 6-15, 17, 43, and 49-56 were cancelled. Arguments were presented by Mr. Krueger in an attempt to overcome the outstanding rejections. Additionally, a declaration by Mr. Doyle was filed under "Rule 132"[50] to support the arguments made in favor of patentability. The Doyle declaration included his explanation why the combination of references used in the rejection was not obvious. [EOLASTX-0000007857-911]

60. On August 25, 1997 the next Office Action in the '443 application was mailed. Claims 1, 2, 5, 44, 45, and 48 were rejected as unpatentable over Applicant's disclosed prior art in view of Koppolu (U.S. patent 5,581,686). Additionally, claims 3-4 and 46-47 were rejected as unpatentable over the above combination further in view of Moran. This Action was made final. [EOLASTX-0000007912-917]

61. On October 31, 1997 a response to the outstanding Office Action was filed. This response included a declaration by Mr. Doyle under "Rule 131" swearing behind the filing date of the parent of the Koppolu reference. Mr. Doyle declared that the subject matter of the claimed invention was reduced to practice in this country prior to April 15, 1994. [EOLASTX-0000007942-44; EOLASTX-0000007919-7938 (attachments)]

62. On November 6, 1997 a personal interview was held including Mr. Doyle, Mr. Krueger, and Examiner Dinh. A demonstration was conducted and the claims were

[50] 37 CFR § 1.132.

discussed. [EOLASTX-0000007939-440 (stating interview was scheduled); EOLASTX-0000007963 (discussing interview)]

63. On December 23, 1997 another "Rule 131" declaration signed by Mr. Doyle was filed. Mr. Doyle declared that the claimed invention was reduced to practice in this country before April 15, 1994. Additionally, arguments were presented by Mr. Krueger in an attempt to overcome the outstanding rejections. [EOLASTX-0000007946-47

64. On January 27, 1998 a telephonic interview was held between Examiner Dinh and Mr. Krueger. Agreements were reached to amend claims 1 and 44. [EOLASTX-0000007987-88]

65. On February 25, 1998 an appeal to the "Board of Appeals and Interferences" was filed captioned Expedited Procedure Examining Group 2317. [51] [EOLASTX-0000007986]

66. On March 30, 1998 the PTO mailed a Notice of Allowability and Notice of Allowance. [EOLASTX-0000007991-96] An examiner's amendment was made to claims 1 and 44 as agreed to in the interview of January 27, 1998. The examiner stated that the Rule 131 affidavit filed January 9, 1997 was "persuasive to antedate the Vetter reference and the in-part of Koppolu".[52] Additionally, a reasons for allowance was included by Examiner Dinh as follows:

[51] Based on my experience this appeal was filed to keep the application "alive" to avoid abandonment and allow the examiner to make the necessary amendments to place the application in condition for allowance.

[52] Mr. Krueger explained that the Koppolu '686 was a continuation of a C-I-P application filed on April 15, 1994. The Koppolu '686 patent also claimed the benefit of a prior application filed on December 1, 1992. The Doyle declaration under 37 CFR 1.131 swears behind the April 15, 1994 (the C-I-P date) but not the December 1, 1992 grandparent date because it was argued that the subject matter that was added to the C-I-

> The claims are allowable over the prior art of record because the prior art does not teach nor reasonably suggest the claimed combination of a browser, while parsing a hypermedia document in a distributed hypermedia environment, automatically invokes an external executable application associated with an embedded object to provide interactive processing and to display the object within an area of the hypermedia document's display window.
>
> The examiner agrees that the claimed external executable application is not a code library extension nor object handler (e.g. windows d11 and OLE) as pointed out in applicant's argument (paper #19 pages 12-14). [EOLASTX-0000007994-95]

67. The issue fee was paid on April 3, 1998 and the '443 application issued as the '906 patent on November 17, 1998. [EOLASTX-0000007992]

68. At no time during the original prosecution of the '906 patent did inventor Doyle or his representative, Mr. Krueger, disclose *any* information regarding ViolaWWW browser to the PTO. As more fully explained below, Mr. Doyle and Mr. Krueger were aware of material information related to the ViolaWWW browser that was not disclosed to the PTO during the prosecution of the '906 patent. That information included but was not limited to 1) the Viola Article published on August 16, 1994; 2) the public demonstrations (public uses) of the ViolaWWW browser that Mr. Pei Wei, the ViolaWWW developer, informed Mr. Doyle occurred more than one year prior to the filing of the '906 patent application; 3) the published ViolaWWW source code; 4) the prior invention of the claimed subject matter by Mr. Pei Wei; 5) and any of the correspondence received by Mr. Doyle from Mr. Pei Wei and others regarding the prior invention of the ViolaWWW browser. In addition, other prior art that is considered material to patentability by Dr. Phillips, the defendant's technical expert, but was not

P application (that was not in the grandparent application) was relied on in rejecting the claims of the '906 application.

considered by the PTO during the prosecution of the '906 patent included: MediaView[53]; Vplot; and Cohen (U. S. patent no. 5,367,621). Furthermore, MediaView and Vplot, which Dr. Phillips considers to anticipate the claims of the patents-in-suit, were not considered by the PTO during the subsequent '906 reexaminations or the prosecution of the '985 patent.

69. After reviewing Eolas' infringement contentions against Adobe, I understand that Eolas accuses Adobe Acrobat of infringement. I understand that Adobe Acrobat 1.0 was released on June 15, 1993.[54] [ADBE0196062-71] On July 19, 1993 David Martin sent an email to Marc Solomon regarding Adobe's PDF file format for Acrobat, copying Cheong Ang and Michael Doyle on that same message. [Email from Martin to USCF re: Acrobat (07/19/1993)]. One month later, on August 19, 1993, Mr. Martin signed a non-disclosure agreement for Acrobat. [ADBE0195776.] Acrobat was never disclosed in the '906 patent prosecution, the first or second reexaminations of the '906 patent, or the '985 patent prosecution.

B. Reexamination of the '906 Patent

The First Reexamination

70. On October 14 and October 24, 2003 the PTO received prior art submissions under 35 U.S.C. § 301 and 37 CFR § 1.501 in relation to the '906 patent. [EOLASTX-0000007064] On October 30, 2003 the PTO Issued a Notice of Director Ordered Reexamination of the '906 patent indicating that reexamination of the '906 patent was ordered and that the reexamination proceeding would be assigned control

[53] Inventor Martin received an email from Christopher McRae on September 8, 1993 informing him of MediaView.

[54] I understand there may be other releases in 1993.

number 90/006,831 ("the '831 reexamination proceeding").[55] [EOLASTX-0000004543-551]

71. The Reexamination Order stated that a substantial new question of patentability existed with respect to claims 1-3 and 6-8 of the '906 patent based on prior art acknowledged by the patentee and newly considered prior art teachings of Berners-Lee, Raggett I, and Raggett II. [EOLASTX-0000004543-551]

72. On December 30, 2003 the patent owner's representative, Mr. Krueger filed an IDS. Mr. Krueger stated that a CD entitled "Viola Source Code" was attached including Earlier Viola Source Code (May 12, 1993) and Later Viola Source Code (May 27, 1993).[56] Mr. Krueger further informed the PTO that District Court Judge Zagel had ruled that neither was a public document that qualified as prior art under 35 U.S.C. §§102 and 103.[57] [EOLASTX-0000005263-66] Even though the Federal Circuit, in the decision of March 2, 2005, overruled the district court decision and ruled that DX 34 was a public

[55] I may refer to this reexamination proceeding as the "first reexamination". 37 CFR § 1.520 establishes authority for Director ordered reexaminations when prior art patents or printed publications are brought to the Director's attention that raise a substantial new question of patentability. Also see MPEP 2239. In ordering reexamination the PTO stated that a "substantial outcry from a widespread segment of the affected industry has essentially raised a question of patentability with respect to the '906 patent claims." In my experience this would have been a typical basis for a Director ordered reexamination.

[56] I will refer to the so-called the Earlier Viola Source Code (May 12, 1993)as DX 34 and the Later Viola Source Code (May 27, 1993) as DX 37.

[57] I note that it was later determined by the Federal Circuit on March 2, 2005 that in fact the public use (demonstration) of the ViolaWWW code *was* prior art under 35 U.S.C. § 102(b). See *Eolas Technologies Inc. et al. v. Microsoft Corp*., 399 F. 3d 1325 at 1335, (Fed. Cir. 2005). However, public use may not be used as a basis for rejection in reexamination as explained above. I also note that the PTO later determined that the Viola DX 37 code was considered a publication and therefore prior art under 35 U.S.C. §§102 and 103. However, as disclosed by Mr. Krueger (during a second reexamination proceeding) the CD containing the "Viola Source Code" submitted in this reexamination proceeding was incomplete. [EOLASTX-0000003585-589]

use and DX 37 was a prior art publication, Mr. Krueger never informed the examiner that his previous statements regarding DX 34 and DX 37 were inaccurate.

73. On January 17, 2004 Mr. Krueger filed a Supplemental Submission under 37 CFR 1.565 (a). [EOLASTX-0000005267-70]

74. On February 26, 2004 the PTO mailed the first Office Action in the first reexamination proceeding. Claims 1-3 and 6-8 were rejected as unpatentable over prior art acknowledged by the patentee and newly considered prior art teachings of Berners-Lee, Raggett I, and Raggett II. Claims 4-5 and 9-10 were rejected based on the above combination further in view of Reichard and Cox. This Office Action was signed by Examiner Andrew Caldwell. Examiner Caldwell also stated that Earlier Viola Source Code (May 12, 1993), DX 34, and Later Viola Source Code (May 27, 1993), DX 37, provided on a CD *were not considered* because claims in a reexamination proceeding are examined on the basis of patents or printed publications (37 CFR § 1.552(a)) and the applicants have neither admitted or provided evidence that the Viola source code is a publication. [EOLASTX-0000005387-398]

75. On March 17, 2004, the PTO mailed an Ex Parte Interview Summary indicating that a telephonic interview was held on March 16, 2004 between Mr. Krueger and Examiner Caldwell. Examiner Caldwell indicated that a personal interview was scheduled for April 27, 2004. [EOLASTX-0000005825-27]

76. On April 22, 2004 Mr. Krueger filed a Interview Request Sheet including a brief summary of the arguments to be presented at the interview of April 27. [EOLASTX-0000005842-46]

77. On April 27 , 2004 a personal interview was held including Mr. Krueger and Mr. Doyle as well as PTO representatives Examiners Caldwell, Pinchus Laufer, and Elizabeth Dougherty. A PowerPoint demonstration was given by the patent owner. The prior art was discussed. It was agreed that a written response would be filed. [EOLASTX-0000005850]

78. On May 10, 2004 a response to the outstanding Office Action was filed by Mr. Krueger. Arguments in favor of patentability were included as well as declarations under 37 CFR §1.132 by Edward Felten, Mr. Krueger, and Mr. Doyle. [EOLASTX-0000006000-02 (Doyle Declaration); EOLASTX-0000006013-6023 (Felten Declaration); EOLASTX-0000006041-43 (Krueger Declaration)]

79. On August 16, 2004 the PTO mailed the next Office Action in the first reexamination proceeding. Claims 1-10 were rejected as unpatentable in view of admitted prior art in the '906 patent and the teachings of Berners-Lee, Raggett I, Raggett II, and Toye. This Action was signed by Examiner Caldwell. [EOLASTX-0000006323-341]

80. A response to the Office Action of August 16, 2004 was received in the PTO on October 12, 2004. Mr. Krueger presented arguments in an attempt to overcome the outstanding rejections. [EOLASTX-0000006534-563]

81. On September 15, 2005 Mr. Krueger filed a paper titled Office Interview of 18 August 2005. Mr. Krueger stated that attendees at the interview were Mr. Doyle, Mr. Krueger, Examiners St. John Courtenay III and Mark Reinhardt.[58] He further stated that the rejections and prior art were discussed in connection with a set of slides. He also

[58] I note that Examiner Caldwell was no longer the examiner in charge of the reexamination proceeding and Examiner Courtenay had taken over responsibility for the reexamination proceeding.

stated that the examiner indicated that OPLA[59] was considering whether the Viola code should be considered as a publication.[60] [EOLASTX-0000006825]

82. On September 27, 2005 the PTO mailed the Notice of Intent to Issue the Reexamination Certificate (NIRC) in the first reexamination proceeding. Claims 1-10 were confirmed. An Interview Summary form was included summarizing the interview of August 18, 2005. Reasons for patentability were also included. Further, Examiner Courtenay indicated that the Viola DX 37 code was considered a publication by the PTO that constitutes prior art and gave rationale for the allowance of the claims over the DX 37 code (pages 45-61). However, as more fully explained below, Mr. Krueger later informed the PTO that the Viola materials (DX 34 and DX 37) submitted to Examiner Courtenay for review was *incomplete*. Mr. Krueger informed the PTO that the CD containing DX 34 and DX 37 submitted in this reexamination *were not submitted in their entirety*. This information was conveyed to the PTO during the second reexamination proceeding and after the first reexamination proceeding was completed. Therefore Examiner Courtenay did *not* have the entirety of DX 37 when he conducted his review. [EOLASTX-0000006893-969; EOLASTX-0000006942-43 & EOLASTX-0000007020-7021] Furthermore, I am informed by Dr. Phillips that based on Examiner Courtenay's explanation in the NIRC in the first reexamination proceeding of his analysis of the DX 37 code, the search and review of DX 37 was flawed or was incomplete because there was no discussion by Examiner Courtenay of a plotting capability, which should reveal

[59] Office of Patent Legal Administration.

[60] I note that the decision in the *Eolas v. Microsoft* litigation had been decided six months earlier (on March 2, 2005) and the Federal Circuit decided that the Viola browser constitutes prior art. See *Eolas Tech. v. Microsoft Corp*., 399 F .3d 1325 at 1336, (Fed. Cir. 2005).

plot.v and other material parts of DX 37, which should have been accessed or reviewed and therefore no indication that the material portion of DX 37 was considered by the Examiner Courtenay.

83. On October 16, 2005 a facsimile was submitted to the PTO regarding a possible interference involving the subject matter under reexamination. [EOLASTX-0000006971-72]

84. On January 20, 2006 the PTO mailed a Supplemental NIRC in the first reexamination proceeding repeating the information from the initial NIRC. [EOLASTX-0000006974-7048]

85. On June 6, 2006 the PTO published the Reexamination Certificate resulting from the first reexamination proceeding of the '906 patent. [EOLASTX-0000003004-3014]

The Second Reexamination

86. On December 22, 2005 a request for *ex parte* reexamination of the '906 patent was filed by Stephen Wright of the law firm of Klarquist Sparkman LLP. EOLASTX-0000003775-3800 This proceeding was assigned control no. 90/007,858 and was the "second reexamination" proceeding of the '906 patent. The requester cited the Jenssen prior art reference indicating that the patent owner had failed to disclose it to the PTO during the first reexamination proceeding and that it established a substantial new question of patentability. Additional references were cited in an IDS.

87. On February 9, 2006 the PTO mailed the Order Granting the Request for Reexamination of the '906 patent. The reexamination proceeding was assigned to Examiner Courtenay. Examiner Courtenay stated that a substantial new question of

patentability was raised by the Janssen reference when combined with other prior art. Additionally, Examiner Courtenay stated that Doyle et al[61] also raised a substantial new question of patentability. [EOLASTX-0000003628-39]

88. On June 29, 2006 the PTO mailed a Decision Removing Non-Enterable Papers from the Record. This decision stated that the patent owner filed a petition on April 17, 2006 requesting an "early interview". The PTO decision denied the petition and stated that the petition lacked entry right and ordered removal of the patent owner petition from the file history. Further, the PTO decision stated that the third party requester "Reply Under 37 CFR 1.535" filed on May 9, 2006 also lacked entry right and was removed form the file history. [EOLASTX-0000003619-627]

89. On August 21, 2006 an IDS was filed by the patent owner's representative, Mr. Krueger. [EOLASTX-0000003606-618] On September 12, 2006 a second IDS was filed by Mr. Krueger. [EOLASTX-0000003597-602] On November 1, 2006 a third IDS was filed by Mr. Krueger. Mr. Krueger stated that information was being submitted on CDs (including DX34 and DX37) because printing out all would result in about forty boxes of documents. He indicated that printouts of the humanly readable files on the CDs labeled DX34 and DX 37 were included. [EOLASTX-0000003590-96]

90. On November 29, 2006 Mr. Krueger filed a "Letter re: IDS Filed on Nov 1, 2006." Mr. Krueger stated that the November 1, 2006 IDS cited several CDs including Viola information. He also indicated that the November 1, 2006 letter included factual

[61] "Processing Cross-sectional Image Data for Reconstruction of Human Anatomy from Museum Specimens," Newsletter of the Association for computing Machinery Special Interest Group on Biomedical Computing, vol.3, no. 1 ACM Press cover page, table of contents, pages 9-15 (February 1993).

inaccuracies regarding the first reexamination and that the CD containing Viola information, DX 34 and DX 37 filed in the first reexamination was "not submitted in their entirety". He stated that DX 34 and DX 37 were submitted in their entirety in the CDs filed in the second reexamination on November 1, 2006. [EOLASTX-0000003585-96]

91. On January 4, 18, and 25, 2007 Mr. Krueger filed additional IDSs. [EOLASTX-0000003519-3524 filed January 25, 2007]; 1/23/2007 [EOLASTX-0000003525-36 filed January 18, 2007]; [EOLASTX-0000003537-85 filed January 4, 2007]

92. On June 4, 2007 the patent owner filed a petition under 37 CFR 1.182 requesting clarification on whether the submission of documents on a CD that can be read using a Windows PC was in compliance with 37 CFR 1.98. [EOLASTX-0000003513-518]

93. On June 7, 2007 Mr. Krueger filed an IDS. [EOLASTX-0000003504-509] On June 14, 2007 Mr. Krueger informed the reexamination examiner that an interference had been declared between the '906 patent and application serial number 09/442,070. [EOLASTX-0000003502-03]

94. On July 3, 2007 the patent owner filed a petition to stay the reexamination proceeding pursuant to 37 CFR § 1.182 [EOLASTX-0000003384-391]

95. On July 24, 2007 the PTO mailed a decision dismissing the petition to stay the reexamination proceedings. [EOLASTX-0000003377-383]

96. On July 30, 2007 the PTO mailed the first Office Action in the second reexamination proceeding. Claims 1-10 were rejected as being anticipated by the "Viola

Article" written by Pei Wei having a date of August 16, 1994.[62] Claims 1-3 and 6-8 were rejected as obvious in view of Cohen et al (U.S. patent 5,367,621) in view of the "Introducing NCSA Mosaic" article. Further, Examiner Pokrzywa (the examiner now handling the second reexamination proceeding) stated that while the Viola DX 37 source code files were not sufficient in expressly teaching each of the limitations of the independent claims 1 and 6 *as noted by the Examiner in the first reexamination*, Examiner Courtenay, the Viola Article can be interpreted as teaching each of the limitations.[63] It is apparent from this statement that Examiner Pokrzywa relied on the analysis and statements made by Examiner Courtenay in the first reexamination proceeding regarding the DX 37 source code. I note that as explained above the source code (on CD) provided to the PTO during the first reexamination was "not submitted in its entirety" [64] and the analysis of the DX 37 source code made by Examiner Courtenay was flawed. [65] Examiner Pokrzywa further noted: "[w]ith the large number of references submitted in the above noted PTO/SB/08As and PTO-1449s, the references were considered to at least the 'degree to which the party filing the information citation has explained the content and relevance of the information' and in 'the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior are in a proper search field.'"[66] I note that no explanation of the

[62] "A Brief Overview of the VIOLA Engine, and its applications" pages TT05441-TT05600 which include the "VIOLA in a Nutshell: the VIOLA World Wide Web Toolkit". [EOLASTX-0000003252]

[63] Pages 12-13.

[64] Mr. Krueger's statement in the paper dated November 29,2006. [EOLASTX-0000003585]

[65] Based on Dr. Phillips' analysis as stated above.

[66] Examiner Pokrzywa cited MPEP 2256 and 609.05(b).

relevance of the information submitted was provided by Mr. Krueger in the numerous IDS submissions discussed above. Therefore Examiner Pokrzywa would have considered the information contained in the IDS submissions in the same manner as other documents in Office search files are considered when doing a prior art search.

97. On September 6, 2007 the PTO mailed an Ex Parte Reexamination Interview Summary indicating that a personal interview was held on that date. Examiners Pokrzywa, Lao, and Foster participated for the PTO and Mr. Krueger and Mr. Doyle for the patent owner. A demonstration was presented. The Examiners noted that the patent owner claimed that the invention was reduced to practice prior to August 16, 1994 and that he intended to file documents under 37 CFR 1.131 [to swear behind the Viola Article]. Additionally, differences between Cohen et al and the claimed invention were discussed. [EOLASTX-0000003300-01]

98. On September 7, 2007 the PTO mailed a decision on the petition filed by the patent owner on June 8, 2007 requesting clarification on whether information submitted on a CD is in compliance with 37 CFR § 1.98. The petition was dismissed indicating that the *CD submissions were not in compliance with PTO rules and that only documents filed in paper format would be considered*. [EOLASTX-0000003292-97]

99. On September 27, 2007 Mr. Krueger filed a response to the outstanding Office Action. Mr. Kruger stated that a Rule 131 declaration signed by Mr. Doyle was included swearing behind the Viola Article thus eliminating it as prior art.[67] Additionally,

[67] I note that while PTO regulations permit the patent owner to "swear behind" the publication date of the Viola Article because it was published less than one year before the filing date of the '906 patent application, PTO regulations would not have permitted a patent applicant to swear behind the May 7, 1993 public use of the ViolaWWW browser since it occurred more than one year prior to the filing date of the '906 patent application.

a declaration under Rule 132 was included by Edward Felton in addition to arguments made in favor of patentability. [EOLASTX-0000003251-291]

100. On January 8, 2008 Mr. Krueger filed an IDS responsive to the denial of the patent owner's petition regarding the previous CD submission. [EOLASTX-0000003230-234]

101. On April 18, 2008 the PTO mailed the next Office Action in the reexamination proceeding. Examiner Pokrzywa stated that the declaration under 37 CFR § 1.131 filed October 1, 2007 (certificate of mailing dated September 27, 2007) was sufficient to overcome the Viola Article reference and therefore the rejection based on the Viola Article was withdrawn. Claims 1-3 and 6-8 were rejected as anticipated by Cohen. Further, the examiner stated that the IDS submission dated 10/31/07 and 1/8/08 do not comply with 37 CFR § 1.98 and were not considered.[68] [EOLASTX-0000003172-210] On June 3, 2008 the PTO mailed an Ex Parte Reexamination Interview Summary indicating that telephonic interviews were held on June 3, 2008 and May 9, 2008 and that proposed amendments to the claims were discussed. [EOLASTX-0000003174]

102. On June 17, 2008 Mr. Krueger filed a response to the outstanding Office Action. Claims 1, 4, 5, 6, 9, and 10 were amended. Since claims 2, 3, 7, and 8 depend from these amended claims they are also considered amended. Claims 11-14 were added. Arguments in favor of patentability were included. Additionally, as noted above broadening claims in reexamination by amendment or the additional of new claims is prohibited. Therefore the scope of the claims resulting from the second reexamination

[68] Pages 15-16. Rule 98 requires that paper copies of the patents and printed publications be submitted.

proceeding of the '906 patent must be narrower (or the same) in scope than the original '906 patent claims.[69] [EOLASTX-0000003159-71]

103. On July 15, 2008 Mr. Krueger filed a Notice of Appeal. [EOLASTX-0000003153-54]

104. On August 19, 2008 Mr. Krueger filed a request for an extension of time. [EOLASTX-0000003149-152]

105. On September 5, 2008 Mr. Krueger filed a Patent Owner's Statement of the Substance of the Interview indicating that an interview was held on August 8, 2008. [EOLASTX-0000003036-37]

106. On September 10, 2008 the PTO mailed the NIRC in the second reexamination. Claims 1-10 as amended and new claims 11-14 were allowed. Examiner Pokrzywa again stated that the Viola Article dated August 16, 1994 was overcome as prior art by the declaration under 37 CFR §1.131. Additionally, reasons for allowance were included indicating the reason the claims were allowed over the Cohen prior art. [EOLASTX-0000003020-28]

107. On September 22, 2008 the PTO mailed a decision on the petition for an extension of time that was filed on August 19, 2008. The petition was dismissed as moot. [EOLASTX-0000003015-19]

108. The reexamination certificate concluding the second reexamination of the '906 patent was published on February 3, 2009. As a result of this reexamination claims 1-10 of the '906 patent were amended and new claims 11-14 were added. [EOLASTX-0000003004-014]

[69] MPEP 2209 and 37 CFR § 1.530.

B. The '985 Patent Prosecution

109. The application that ultimately issued as the '985 patent was filed on August 9, 2002 and was assigned serial number 10/217,955 ("the '955 application"). The named inventors were Michael D. Doyle, David C. Martin, and Cheong S. Ang. The application was filed by the inventor's representative, Mr. Charles Krueger. It was indicated that this application was a continuation and claimed the benefit of application no. 09/075,359 filed May 8, 1998 which was a continuation of application no. 08/324,443 filed on October 17,1994 [the '906 patent]. [EOLASTX-0000008984-9072]

110. On September 11, 2002 the PTO mailed a Notice of Missing Parts indicating the fee was missing. [EOLASTX-0000008982-83] The missing fee was filed on April 8, 2003. [EOLASTX-0000008980] On May 15, 2003 a request for refund was filed. [EOLASTX-0000008966-69] On August 30, 2003 Mr. Krueger filed an IDS and a supplemental IDS. [EOLASTX-0000008972-76]

111. On July 20, 2004 the PTO mailed the first Office Action in the '955 application. Claims 1-10 [70]were rejected as unpatentable over the admitted prior art in the '906 patent and the teachings of Berners-Lee, Raggett I, Raggett II, and Toye. Claim 2 was rejected on the grounds of statutory double patenting in view of the '906 patent and claims 1 and 3 were rejected on the grounds of obviousness-type double patenting in view of the '906 patent. This Action was signed by Examiner Andrew Caldwell. [EOLASTX-0000008943-54]

112. On March 11, 2005 the PTO received a response to the outstanding Office Action. Claim 2 was cancelled. Arguments were presented in favor of patentability.

[70] This was an apparent typo since only 3 claims were presented for examination.

Additionally, a declaration under 37 CFR §1.132 by Edward Felton was filed to support those arguments. Additionally, a terminal disclaimer was filed to overcome the obviousness-type double patenting rejection. [EOLASTX-0000008864-8933]

113. On May 5, 2006 the PTO mailed a Notice suspending action in the '955 application for 6 months pending outcome of the reexamination of the '906 patent. [EOLASTX-0000008862-63]

114. On October 24, 2005 Mr. Krueger filed an IDS and indicated that the submission included CD(s) that included Viola source code. The file includes a PTO form indicating that the CD(s) were "not proper subject matter". [EOLASTX-0000008858-61 (IDS received on 11/27/2005); EOLASTX-0000008855 (note stating not proper subject matter)]

115. The PTO mailed a Notice on January 18, 2006 again suspending action for 6 months pending outcome of the reexamination of the '906 patent. [EOLASTX-0000008853-54]

116. On September 12, 2006 Mr. Krueger filed an IDS which included "4 boxes". [EOLASTX-0000008848-52] On January 24, 2007 another IDS was filed. [EOLASTX-0000008810-13]

117. On October 18, 2006 the PTO mailed a notice again suspending action for 6 months. [EOLASTX-0000008831-32]

118. On December 28, 2006 Mr. Krueger filed an IDS indicating that "7 boxes of NPL" was included. [71] He further indicated that printing out all of the information on the CDs would result in about forty boxes of documents. In light of that a decision was

[71] NPL is Non-Patent Literature.

made to submit the bulk of the documents in electronic form. [EOLASTX-0000008825-28] On January 8, 2007 an additional IDS was filed. [EOLASTX-0000008814-8824] On January 24, 2007 another IDS was filed. A PTO form included in the file history indicated "7 CD's enclosed in artifact folder". [EOLASTX-0000008803-813] On January 31, 2007 another IDS was filed. A PTO form in the file indicates: "not proper subject matter for CD submission". [EOLASTX-0000008797-8802]

119. On May 3, 2007 another IDS was filed. [EOLASTX-0000008972-76] On June 18, 2007 another IDS was filed, "1 box of NPL Literature" was included. [EOLASTX-0000008623-25]

120. On August 13, 2007 the PTO again suspended action for 6 months. [EOLASTX-0000008621-22]

121. On October 9, 2007 another IDS was filed, "1 box of NPL" was included. On October 24, 2007, December 3, 2007, December 11, 2007, and February 22, 2008 additional IDS submissions were filed. [EOLASTX-0000008531-8620]

122. On April 11, 2008 Mr. Krueger filed a supplemental amendment canceling claims 1-3 and adding new claims 4-50. [EOLASTX-0000008508-525]

123. On April 9, 2008 the PTO again suspended action in the '955 application for 6 months. [EOLASTX-0000008505-07]

124. On November 13, 2008 Mr. Krueger filed the NIRC from the second reexamination of the '906 patent in the '955 application asking that the suspension of action be removed. [EOLASTX-0000008492-8502]

125. On February 5, 2009 Mr. Krueger filed an amendment responsive to the Office Action of September 9, 2004.[72] Several pending claims were amended. This response also indicated that a personal interview was held with Examiner Donaghue, Mr. Krueger, and Mr. Doyle on January 8, 2009. [EOLASTX-0000008401-485]

126. On March 20, 2009 a Notice of Allowance and Notice of Allowability were mailed by the PTO. [EOLASTX-0000008366-370] Claims 4-49 were allowed. Examiner Donaghue indicated that thirteen IDS submissions, totaling twenty-seven pages, were all considered on March 1, 2009.[73] Examiner Donaghue included a reasons for allowance as follows:

> The claims are allowable as the claims contain the subject matter deemed allowable in both Re exam 90/006,831 and Re exam 90/007,838 for the same reasons as set forth in the NIRC of the two Re exams. [EOLASTX-0000008369]

127. The issue fee was paid on March 30, 2009. [EOLASTX-0000008346] Additionally, Mr. Krueger filed a paper noting two typographical errors in the Notice of Allowability. [EOLASTX-0000008347]

[72] I note that there is no Office Action in this application dated September 9, 2004. The remarks section of this response indicates that the Office Action was mailed on July 20, 2004.

[73] These IDS submissions contain approximately 251 separate citations totaling thousands of pages of information. I also note that examiner Donaghue searched 6 classes and 22 subclasses on that same day, March 1, 2009. I note that PTO examiners have a production goal or quota that permits on average approximately 20 hours of examination time per application from start to finish. *See* the Report by the National Academy of Public Administration, "U.S. Patent and Trademark Office: Transforming to Meet the Challenges of the 21st Century", August 2005 at page xix of the Executive Summary

128. On March 26, 2009 a Office communication was mailed indicating that three IDS submissions were attached, totaling 14 pages, and that these IDS submissions were considered on March 24, 2009.[74] [EOLASTX0000008348-63]

129. The '955 application issued as the '985 patent on October 6, 2009. [EOLASTX-0000006466-494]

IV. MY ANALYSIS AND OPINIONS

A. The ViolaWWW Browser Was Invented by Another and in Public Use More Than One Year Prior to the Filing Date of the '906 Patent Application and Therefore Was Prior Art Under 35 U.S.C. § 102 (b) and (g)

130. 35 U.S.C. §102 (b) bars the patenting of an invention if the invention was in public use in this country more than one year prior to the filing date of the application for patent in the United States. I have reviewed evidence that in my opinion proves that the ViolaWWW browser was in public use more than one year prior to the filing date of the '906 patent application and therefore prior art under 35 U.S.C. § 102 (b).[75] The filing date of the '906 patent application was October 17, 1994. The "critical date" for establishing a bar to patentability is therefore October 17, 1993. As discussed below the ViolaWWW browser was publicly used prior to the October 17, 1993 critical date.

[74] Examiner Donaghue had failed to indicate that these previously filed IDS statements had been considered when mailing the initial Notice of Allowability. The IDS submissions total an additional 186 separate submissions totaling thousands of pages of information.

[75] **35 U.S.C. § 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

131. Additionally, as discussed below, I have reviewed evidence that the ViolaWWW browser was invented by another (Mr. Pei Wei) in this country prior to the invention of the subject matter of the '906 patent application and was not abandoned, suppressed or concealed, and therefore was prior art under 35 U.S.C. § 102 (g) (2). [76]

132. In reaching my conclusions and opinions expressed below I have relied on Dr. Phillips, the defendant's technical expert, regarding the technical content of the prior art and the '906 or '985 patents. I have also relied on Dr. Phillips' explanation and opinions with respect to the technology of the prior art and subject matter of the patents – in-suit as indicated above in Section III. of my report which summarizes the prosecution histories of the patents-in-suit.

133. On May 7, 1993 Mr. Pei Wei, the developer of the ViolaWWW browser and Mr. Scott Silvey, an associate of Mr. Wei's demonstrated the ViolaWWW browser to two Sun Microsystems engineers, Karl Jacobs, and James Kempf. [77] [DX 135 - EOLASTX-0000022474; Pei Wei *Eolas v. Microsoft* trial testimony at 2278-2284 (describing the demonstration to Sun)] Mr. Wei and Mr. Silvey worked for O'Reilly &

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[76] **35 U.S.C. § 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless –

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

[77] DX 135 - EOLASTX-0000022474.

Associates at the time. [Pei Wei *Eolas v. Microsoft* trial testimony at 2413:3-13.] The version of the ViolaWWW browser demonstrated was later designated DX 34.[78] The demonstration included the so-called "fighter plane plotting demo" which I understand from Dr. Phillips illustrates that the ViolaWWW browser includes the features or claim limitations of the '906 patent. [DX 135 - EOLASTX-0000022474, Pei Wei *Eolas v. Microsoft* trial testimony at 2280:10-14]

134. On May 31, 1993 Mr. Wei posted DX 37, a later version of the ViolaWWW browser that continued to include the fighter plane plotting demo on an ftp site making DX 37 available to Mr. Kempf of Sun Microsystems for downloading. [79]

135. At the WWW Wizard's Conference held in Cambridge Mass. on July 28-30, 1993 Mr. Wei and Mr. Silvey demonstrated the ViolaWWW browser including the fighter plane plotting demo to Tim Berners-Lee.[80] Additionally, Mr. Wei testified that he demonstrated the ViolaWWW browser to Marc Andreessen at that conference.[81] These demonstrations were made without restriction or confidentiality agreements. [Pei Wei *Eolas v. Microsoft* trial testimony 2286:11-19 (generally no restriction on disclosing browser – open source), 2288:25-2289:5 (no confidentiality requirements at the conference specifically)]

[78] Pei Wei *Eolas v. Microsoft* trial testimony at 2282-2283 (explaining the difference between DX 34 and DX 37, stating DX 34 was demonstrated).

[79] DX 41 - EOLASTX-0000065008.

[80] Silvey *Eolas v. Microsoft* trial testimony at 2476:4-20.

[81] Wei *Eolas v. Microsoft* trial testimony at 2287:18-25.

136. On October 17, 1993 Mr. Wei sent an email to Jay [Weber] stating that an alpha release of ViolaWWW was available for downloading from the Berkeley ftp site.[82]

137. On October 21, 1993 Mr. Wei received an email from John Cahill at Quarterdeck Office Systems stating that he had downloaded ViolaWWW from the ftp site. [83]

138. The Federal Circuit in their decision dated March 2, 2005 in the previous litigation, *Eolas Technologies v. Microsoft Corporation* involving the '906 patent stated:

> In sum, with respect to the district court's prior art rulings, this court finds: the district court erred in finding as a matter of law that DX34 was abandoned, suppressed or concealed within the meaning of section 102(g); Wei's May 7, 1993 demonstration to two Sun Microsystems employees without confidentiality agreements was a public use under section 102(b); and the district court erred in its JMOL that DX37 did not as a matter of law anticipate or render the '906 patent obvious.

139. Therefore the Federal Circuit reversed the district court decision and ruled that the May 7, 1993 demonstration was a public use under 35 U.S.C. § 102(b). Similarly therefore, the demonstrations at the WWW Wizard's Conference between July 28 and 30, 1993 without confidentiality restrictions would have been public uses under 35 U.S.C. § 102(b). Further the Federal Circuit ruled that DX 37 was prior art. Based on the Federal Circuit decision in the previous litigation these demonstrations and DX 37 which was posted on the Internet for downloading constitute prior art under 35 U.S.C. § 102(b).

140. Additionally, the Federal Circuit found that Mr. Pei Wei had not abandoned, suppressed, or concealed DX 34, the version of the ViolaWWW browser

[82] DX 62 - EOLASTX-0000022428. A understand from Dr. Phillips that the alpha and later beta versions of the ViolaWWW browser also anticipate the claims of the '906 patent. Again, no ViolaWWW browser information was submitted or considered by the PTO during the prosecution of the '906 patent.

[83] DX 63 - EOLASTX-0000022429.

invented by Mr. Wei prior to his demonstration to the Sun Microsystems employees, and therefore in my opinion DX 34 was prior art under 35 U.S.C. § 102(g). The above evidence also establishes that Mr. Wei had invented DX 37 by May 31, 1993 and therefore in my opinion DX 37 was also prior art under 35 U.S.C. § 102(g).

B. The ViolaWWW Browser was Publicly Known and Used by Others Before the Filing of the '906 Patent Application and Therefore Prior Art under 35 U.S.C. § 102(a)

141. The '906 patent application was filed on October 17, 1994. Therefore any knowledge or use by others or patent or printed publication that predates filing date of the '906 application qualifies as prior art under 35 U.S.C. § 102(a). [84] Even though applicants *may* be able to swear behind the date of section 102 (a) prior art, (37 CFR §1.131) they are required to disclose material prior art that qualifies under section 102(a) under the duty of disclosure.

142. On February 25, 1994 Mr. Wei posted an email to a "multiple recipient list" stating the ViolaWWW was available for downloading at the ftp site. He indicated that it was a beta version and that feedback was welcome. [85]

143. On August 16, 1994 Mr. Wei published the "Viola Article" referenced above.[86] This article was an overview of the Viola Engine and included a description of

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[84] **35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

[85] DX 73 - EOLASTX-0000022436.

the fighter plane plotting demo that was demonstrated to the Sun Microsystems engineers and to Tim Berners-Lee at the WWW Wizard's Conference between July 28-30, 1993.

144. On September 20-21, 1994 the ViolaWWW browser was presented at the Stanford Computer Forum WWW Workshop. This presentation included the fighter plane plotting demo discussed above.[87] This was knowledge and use by others before the filing date of the '906 application.

145. The February 25, 1994 posting of the beta version demonstrated that ViolaWWW was known or used by others in this country before the filing of the '906 patent application. The February 25, 1994 posting would qualify as prior art under 35 U.S.C. §102(a). Mr. Doyle had access to this posting and beta version of Viola.[88] Further, the Viola Article published on August 16, 1994 also qualifies as prior art under 35 U.S.C. §102(a). The Viola Article also explains the fighter plane plotting demo demonstrated on May 7, 1993 and July 28-30, 1993, which were public uses under 35 U.S.C. §102 (b) and statutory bars to patentability of the '906 patent application. Similarly, the Stanford presentation on September 20-21, 1994 included the fighter plane plotting demonstration as well. As noted previously, none of this ViolaWWW information was submitted to the PTO or considered by the PTO during the prosecution of the '906 patent application.

146. In summary, the evidence that I have reviewed indicates that ViolaWWW browser that was developed by Mr. Pei Wei was known and used by others before the

[86] "A Brief Overview of the VIOLA Engine, and its applications" pages TT05441-TT05600 which include the "VIOLA in a Nutshell: the VIOLA World Wide Web Toolkit".

[87] Dr. Phillips informs me that the slides from the Stanford Workshop illustrate that the plotting demo is shown within a window in the browser.

[88] DX 147 - EOLASTX-0000168065.

filing dates of the '906 application, as indicated by the February 25, 1994 posting and the September 20-21, 1994 Stanford presentation. Additionally, the Viola WWW Article was published on August 16, 1994, which was before the filing of the '906 application. The public knowledge and use of the ViolaWWW browser as well as the ViolaWWW Article qualify as prior art under 35 U.S.C. §102 (a).

C. Mr. Doyle Had Knowledge of the ViolaWWW Prior Art and Failed to Disclose This Information to the PTO During the Prosecution of the '906 Patent Application

147. As early as November 1993, Mr. Doyle became aware of the Viola browser. In November 1993 Mr. Doyle had discussions with "people from ORA" (O'Reilly & Associates) at the SIG-WEB meeting regarding features in Viola. [89] Mr. Doyle testified that he had discussions with some people at the SIG-WEB meeting in November 1993 but could not remember if the Viola browser was mentioned. He did recall a discussion about a "book browser". [90]

148. On May 20, 1994 Mr. Doyle received an email from Mr. Dave Raggett telling him that he might want to look at Viola regarding embedding. Mr. Raggett informed him that he could find a pointer to Viola off the CREN WWW project page. [Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony at 83:7-22; DX 90 - EOLASTX-0000025961]

149. On August 30, 1994 Mr. Doyle issued a Press Release regarding the subject matter of the '906 patent. The press release stated: "This UC software is the first

[89] DX 102 - EOLASTX-0000043735.

[90] Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony at 81:5-13.

instance where program objects have been embedded in documents over an open and distributed hypermedia environment such as the world Wide Web on the Internet".[91]

150. On the next day, August 31, 1994, Mr. Pei Wei sent an email to Mr. Doyle regarding the Press Release. Mr. Wei stated:

> "This is very interesting…But, I don't think this is the first case of program objects embedded in docs and transported over the WWW. ViolaWWW has had this capabilities for months and months now." [92]

151. On the same day, August 31, 1994, Mr. Doyle responded to the Wei email and asked:

> "How many months and months? We demonstrated our technology in 1993."[93]

152. Mr. Doyle testified that on August 31, 1994 he went to the Internet and read the Viola Article that was published by Mr. Wei on August 16, 1994.[94] He then responded to the Wei email by stating that the Viola paper (the Viola Article of August 16, 1994) did not support "embeddable program objects" until 1994 and that he had demonstrated this in 1993. He made further comments on his perceived differences between Viola and his software. [95]

153. Again, on the same day, August 31, 1994, after responding to the Wei email as described above, Mr. Doyle send another email to Mr. Wei asking:

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[91] DX 826 - EOLASTX-0000022772.

[92] DX 100 - EOLASTX-0000168171.

[93] DX 99 - EOLASTX-0000035966.

[94] Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony 90:2-17.

[95] Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony 90:2-17.

> "Out of curiosity, did you publicly demonstrate this or publish any results before 1994? I remember talking to people from ORA at the first SIG-WEB meeting in November of 1993 and they said that no such features were yet publicly demonstrable in Viola. I seem to remember that they hinted at the time someone was trying to get something to work, but it wasn't ready to show yet." [96]

154. On September 1, 1994 Mr. Wei responded to the first Doyle email asking "How many months and months?". Mr. Wei replied:

> "Not that I wish to content on the point of simply who's first ;) But, let's see…(wish I had kept better records and wrote papers about things as they happened!) Definitely by May 8, 1993 we had demonstrated that plotting demo (the very one shown in the viola paper) to visitors from a certain computer manufacturer…" [97]

155. In a second email on September 1, 1994 Mr. Wei again responded to a Doyle email by stating:

> "Well, Viola's model was *demonstrated* in 1993, *released* freely in 1994." [98]

156. I note that the above communications regarding the ViolaWWW browser between Mr. Doyle and Mr. Wei occurred in the weeks just prior to the date on which Mr. Doyle filed the '906 patent application on October 17, 1994. In my opinion the above communications and testimony clearly demonstrate that Mr. Doyle had knowledge of the ViolaWWW browser, including the fighter plane plotting demo feature described in the Viola Article of August 16, 1994 at the time he filed the '906 patent application. He was also aware that Mr. Wei had demonstrated the ViolaWWW browser including the plotting feature in May, 1993.

[96] DX 102 - EOLASTX-0000043735.

[97] DX 107 - EOLASTX-0000042939. The Sun Microsystems demonstration occurred on May 7, 1993.

[98] DX 111 - EOLASTX-0000025989.

157. When filing the '906 patent application, Mr. Doyle signed a declaration under 37 CFR §1.63. In that declaration he stated that he was the original, first inventor of the subject matter of the '906 patent application and he acknowledged his duty to disclose information material to the examination of the patent application under 37 CFR §1.56. Yet Mr. Doyle failed to disclose any information regarding the ViolaWWW browser that Mr. Pei Wei had previously invented to the PTO at the time of filing the '906 application or at any time during the prosecution of the '906 patent application. Mr. Doyle's duty of disclosure would have included the duty to disclose all material information known to him. This would have included material prior art under 35 U.S.C. §102 (a), (b), and (g).

158. During the prosecution of the '906 patent application Mr. Doyle and Mr. Wei again had communications regarding the ViolaWWW browser and when it was publicly demonstrated. On August 21, 1995, Mr. Doyle issued another Press Release this time announcing that Eolas Technologies had completed an exclusive licensing agreement with the University of California for a patent pending covering the use of embedded program objects within World Wide Web documents.[99] By this time Mr. Doyle had left the University of California where he developed the subject matter of the '906 patent application and had formed Eolas Technologies. [100]

159. On the same day as the above Press Release, Mr. Wei sent Mr. Doyle an email again informing him of the ViolaWWW browser and its public release date. He stated:

[99] DX 196 - EOLASTX-0000026057.

[100] Doyle *Eolas v. Microsoft* trial testimony at 390:4-392:7.

> " I sincerely hope this patent isn't going to stick, for the good of the web as a whole... And for the record, I just want to point out that the "technology which enabled Web documents to contain fully-interactive "in-line" program objects" was existing in ViolaWWW and was *released* to the public, and in full source code form, even back in 1993… Actual conceptualization and existence occurred before '93."[101]

160. Mr. Doyle responded to the above Wei email on the same day, August 21, 1995 stating:

> "Pei, We've had this discussion before (last September, remember?). You admitted then that you did NOT release or publish anything like this before the Eolas demonstrations."

161. Mr. Wei immediately responded to the Doyle email correcting Mr. Doyle. Mr. Wei stated:

> "Please carefully re-read my letter to you… I said Viola was demonstrated in smaller settings, but before your demo. The applets stuff was demo'ed to whomever wanted to see it and had visited our offices at O'Reilly & associates (where I worked at the time)." Mr. Wei then copied parts of his September 1, 1994 email to Mr. Doyle that stated that he had demonstrated the plotting demo by May 8, 1993.[102] He also stated that the plotting demo was shown at the Web Conference in Cambridge. [103]

162. In May of 1998, during the prosecution of the '906 patent application, Mr. Doyle compiled information regarding the ViolaWWW browser information in a folder labeled "Viola Stuff". [DX 147 - EOLASTX-0000168065] This folder included email communications between Pei Wei and Mr. Doyle (that included the Pei Wei assertions of the May 7, 1993 public use demonstration) as well as other information describing the ViolaWWW browser. It also included information regarding the WWW Wizards Conference of July 28-30, 1993.

[101] DX 136 - EOLASTX-0000026004.

[102] The actual date was May 7, 1993.

[103] DX 135 - EOLASTX-0000042942.

163. Based on the evidence discussed above, Mr. Doyle had knowledge of the ViolaWWW browser. He was informed by Mr. Raggett that he should look at the Viola information. He had repeated communications with Mr. Pei Wei, the developer of the ViolaWWW browser. He admitted reading the Viola Article dated August 16, 1994 that described functionalities of ViolaWWW. He was informed by Mr. Wei that the ViolaWWW browser including the fighter plane plotting demo was publicly demonstrated on May 7, 1993, made available to members of the public on May 27, 1993, and again publicly demonstrated at the Cambridge conference between July 28-39 1993. Mr. Doyle had knowledge and access to the Viola 3.0 beta version. Mr. Doyle had knowledge of the Stanford Workshop presentation of September 20-21, 1994 and admitted printing out the Stanford presentation during the prosecution of the '906 patent.[104] Mr. Doyle even collected information regarding the ViolaWWW browser in a folder entitled "Viola Stuff". All of these events occurred before and during the prosecution of the '906 patent application. However, Mr. Doyle failed to disclose *any* information regarding the ViolaWWW browser to the PTO during the prosecution of the '906 patent application.

D. The ViolaWWW Browser Information Withheld from the PTO was Material to the Patentability of the Claims of the '906 Patent

164. In the recently decided *Therasense* decision, as discussed above, the Federal Circuit has established the so-called "but-for" standard of materiality for proving inequitable conduct. The Court held that materiality is now to be determined using the "but-for" standard, which means the withheld prior art is material only if the PTO would not have allowed a claim if it had been aware of the undisclosed prior art. That

[104] DX 121 and Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony 119:6-15.

determination is made using a preponderance of the evidence standard while giving claims their broadest reasonable construction.

165. Using the above described "but-for" standard of materiality, the ViolaWWW browser information, including the public use of the ViolaWWW browser prior to the critical date[105] was material to the claims of the '906 patent.

166. As explained above, I have relied on Dr. Phillips' opinions and conclusions regarding the technology of the prior art and the patents-in-suit in forming my opinions. Dr. Phillips informs me that in his opinion DX 34, the version of the ViolaWWW browser publicly demonstrated and publicly used prior to the critical date, would have rendered as least one claim of the '906 patent unpatentable. He also informs me that the DX 37 prior art would have rendered as least one claim of the '906 patent unpatentable. Additionally, the fighter plane plotting demo illustrated in the Viola Article, but publicly demonstrated and therefore in public use prior to the critical date renders at least one claim of the '906 patent unpatentable. Based on this information alone the public use of the ViolaWWW browser is material and would have been required to be disclosed to the PTO under the duty of disclosure, 37 CFR §1.56.

167. Further, the decision of the Federal Circuit in the *Eolas v. Microsoft* previous litigation is evidence of materiality of the ViolaWWW browser. In the previous litigation involving the '906 patent the Federal Circuit vacated the district court's decision that DX 34 did not constitute prior art and that and DX 37 did not anticipate or render obvious the '906 patent claims. By reversing the district court finding on "prior art defenses" the Federal Circuit found that a reasonable jury could find at least claims 1 and

[105] The critical date for statutory bar purposes under 35 U.S.C. § 102 (b) is October 17, 1993, which is one year prior to the filed date of the '906 patent application.

6 of the ‘906 patent unpatentable in view of the DX 37 prior art and that the DX 34 public use prior art was erroneously excluded as prior art.

168. Further, during the second reexamination of the ‘906 patent, the PTO Examiner rejected claims 1-10 of the ‘906 patent as anticipated by the Viola Article. He stated that the Viola Article can be interpreted as teaching each of the limitations of claims 1-10 of the ‘906 patent. In response to this rejection, Eolas did not argue that the examiner was wrong, but filed a declaration under 37 CFR §1.131 to swear behind the publication date of the Viola Article. I understand from Dr. Phillips that the Viola Article describes the features of the fighter plane plotting demo that was publicly demonstrated and in public use prior to the critical date. Therefore, even though the Viola Article itself was removed as prior art via the declaration under 37 CFR §1.131 in the second reexamination, the underlying plotting demo and ViolaWWW browser in public use prior to the critical date that was described in the Viola Article was material as demonstrated by the PTO rejection of the ‘906 patent on the Viola Article. Stated another way, since the PTO examiner determined that claims 1-10 of the ‘906 patent were anticipated by the information in the Viola Article, and that information was in public use before the critical date, the PTO rejection in the second reexamination indicates that the content of the public use of the ViolaWWW browser was material and would have anticipated the claims of the ‘906 patent. Additionally, the Viola Article itself was prior art under 35 U.S.C. § 102(a). It was material since the examiner found the claims unpatentable in view of the Article. Proper PTO procedure would have required disclosure of the Viola Article as prior art under 35 U.S.C. §102 (a) even though it could have possibly been subject to a declaration under 37 CFR §1.131. Disclosure of the Viola Article could have lead to

further inquires regarding the earliest prior art date of the ViolaWWW browser and may have lead to disclosure of the public uses of ViolaWWW. Additionally, there is no certainty that a declaration under 37 CFR §1.131 would have been sufficient to overcome the Viola Article without submitting it for PTO review. In my opinion disclosure of the Viola Article was required under the duty of disclosure. Failure to disclose it was a violation of the duty of disclosure.

169. As noted above, during the reexaminations of the '906 patent, information regarding DX 34 and DX 37 was submitted to the PTO. However, the file history of the first reexamination indicates that Examiner Courtenay considered the CD submitted by Mr. Krueger that was *not submitted in its entirety*. Therefore, Examiner Courtenay did not have the complete version of DX 37 when he made his analysis. I am informed by Dr. Phillips that in addition to reviewing an incomplete version of DX 37, Examiner Courtenay's search and review of the DX 37 CD was flawed and material portions of the code, including plotting portions and plot.v, were not revealed. Therefore there is no indication that Examiner Courtenay considered the *material* portion of the DX 37 source code. Further, Vplot code was never submitted to the PTO. There is no discussion by Examiner Courtenay in the NIRC that he accessed or reviewed the Vplot executable code.

170. During the second reexamination the PTO determined that information submitted in an IDS on a CD does not comply with 37 CFR §1.98 and therefore is not considered. The file history indicates that Examiner Pokrzywa relied on the analysis made by Examiner Courtenay of DX 37 in the first reexamination when determining that DX 37 did not render the claims of the '906 unpatentable. Examiner Courtney's analysis

of DX 37 was directed to the version of DX 37 that was incomplete and his search of the DX 37 CD was flawed as explained above. The file history indicates that paper copies of DX 34 and DX 37 were submitted during the second reexamination. However, since Examiner Pokrzywa indicated that electronic copies of IDS were not considered and he relied on Examiner Courtney's analysis of DX 37, it is not clear to what extent Examiner Pokrzywa independently considered the paper copies of DX 34 and DX 37. It is my opinion that Examiner Pokrzywa relied on Examiner Courtney's analysis as he stated.

171. Therefore, in my opinion, the prosecution histories of the reexamination proceedings confirm that the information described in the Viola Article was material since it was used to reject claims 1-10 of the '906 patent and was not argued as improper by the patent owner. Since the Article describes the section 102(b) public use of the ViolaWWW browser, the rejection confirms the "but-for" materiality of the ViolaWWW browser prior public use. Further, even though DX 37 was considered by the examiner in the first reexamination, the file history indicates that the examiner did not consider *complete* version of DX 37, and material portions as described by Dr. Phillips were not reviewed and thus the consideration was flawed. Additionally, the examiner in the second reexamination relied on the analysis of DX 37 made by the examiner in the first reexamination. In view of this there is no evidence that the PTO considered the claims of the '906 patent patentable over the material portions of DX 37 during the reexaminations of the '906 patent.

172. Similarly, there is no indication that the examiner of the '985 patent independently evaluated the DX 34 or DX 37 source code. Indeed, Examiner Donaghue suspended action in the '985 patent application for a period of nearly three years waiting

for the conclusion of the reexamination proceedings of the '906 patent. Once the reexaminations were concluded Examiner Donaghue allowed the claims of the '985 patent *for the same reasons* the '906 patent claims were confirmed in reexamination relying on the analysis made by Examiner Courtenay of the Viola Code. As explained above that analysis did not consider the complete version of the DX 37 source code or the plotting code. Nor is there any indication that examiner Donaghue considered the prior public use or prior inventorship of the ViolaWWW browser. In my opinion Examiner Donaghue based the allowance of the '985 patent on the allowance of similar claims in the '906 reexamination.

173. In my opinion, Mr. Doyle violated his duty of candor and duty of disclosure to the PTO by failing to disclose that the ViolaWWW browser had been earlier invented by Mr. Wei and was in public use more than one year prior to the filing date of the '906 patent application. This information was material under the but-for standard of materiality since it would have prevented the issuance of the '906 patent. Additionally, the published Viola Article was material prior art under 35 U.S.C. §102 (a) and as explained above failure to disclose it was also violation of the duty of disclosure.

E. Evidence of Intent to Deceive the PTO

174. I understand that the Federal Circuit, in the recent *Therasense* decision, addressed the intent prong of an inequitable conduct finding by holding that to meet the clear and convincing standard for intent, the specific intent to deceive must be "the single most reasonable inference able to be drawn from the evidence," and the evidence "must be sufficient to *require* a finding of deceitful intent in light of all the circumstances. The

Federal Circuit however held that intent may be inferred from indirect and circumstantial evidence.

175. In my opinion there is significant evidence of intent to deceive that the trier of fact should consider. The single most reasonable inference that can be drawn from the evidence discussed above is that Mr. Doyle intended to deceive the PTO by withholding his information and knowledge that the ViolaWWW browser was invented by another and in public use more than one year prior to the filing of the '906 patent application. Although more fully discussed above, highlights of the evidence of Mr. Doyle's extensive knowledge of the ViolaWWW and the warnings from others including the ViolaWWW browser developer, Mr. Pei Wei include:

- Mr. Doyle's discussions with O'Reilly & Associates people regarding a book browser or Viola on November 19, 1993. [106]
- An email from Mr. Raggett on May 20, 1994 advising him to look at Viola[107]
- An email from Pei Wei on August 31, 1994 informing Mr. Doyle that ViolaWWW has had the capability of program objects embedded in documents and transported over the WWW for months and months[108]

[106] DX 102 - EOLASTX-0000043735; Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony 81:8.

[107] Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony 83:7-22; DX 90 - EOLASTX-0000025961).

[108] DX 98 - EOLASTX-0000061841.

- Mr. Doyle read the Viola Article of August 16, 1994 [109]
- Pie Wei informed Mr. Doyle via an email dated September 1, 1994 that ViolaWWW was demonstrated in 1993 [the May 7, 1993 demo to Sun Microsystems engineers] and released freely in 1994. He also informed Mr. Doyle that he demo'ed the "plotting demo" that was described in the Viola Article in the Sun Microsystems demo. [110]
- On August 21, 1995 in response to a Press Release by Mr. Doyle announcing his patent application, Pei Wei again informed Mr. Doyle that Viola was demonstrated to the public in 1993 including the May 8th demo and the Cambridge demo in August 1993. [111]
- Mr. Doyle compiled a "Viola Stuff" folder during May 1998 that included information on Viola and emails concerning his knowledge of Viola. [112]

176. Despite the above evidence of Mr. Doyle's extensive knowledge of the importance and materiality of the ViolaWWW browser, he did not disclose any of this information to the PTO during the prosecution of the '906 patent application. He did however disclose less material information to the PTO during the '906 prosecution indicating his intent to deceive the PTO by withholding the most damaging

[109] Doyle *Eolas v. Microsoft* inequitable conduct hearing testimony 90:4.

[110] DX 107 - EOLASTX-0000042939.

[111] The Cambridge demo was actually on July 28-30 1993 at the WWW Wizards Conference.

[112] DX 147 - EOLASTX-0000168065.

information.[113] Further, as indicated by the initial judgment in the previous litigation, Mr. Doyle had a substantial financial interest in obtaining the '906 patent.

177. As a named inventor Mr. Doyle clearly is covered by the duty of candor and duty of disclosure in the PTO regulations.[114] Further, Mr. Doyle was closely involved in the prosecution of the '906 patent. He attended personal interviews at the PTO with PTO examiners, reviewed communications from the PTO, and participated in formulating responses to the PTO. [115] He was well aware of the assertions made by Mr. Wei that the ViolaWWW browser was prior art to the '906 patent application but he chose to kept this information from the PTO.

178. In my opinion the single most reasonable inference that can be drawn from the evidence discussed above is that Mr. Doyle withheld the ViolaWWW information from the PTO with an intend to deceive the PTO. The evidence indicates that had the ViolaWWW public use or prior invention been disclosed to the PTO the '906 patent would not have issued. The indirect and circumstantial evidence indicates that Mr. Doyle knew this and chose to withhold the ViolaWWW browser information from the PTO.

F. Mr. Krueger's Failed to Make a Reasonable Inquiry and Disclose the Prior Public Use of the ViolaWWW Browser

[113] Mr. Phillips informs me that ViolaWWW anticipates the claims of the '906 patent and is not cumulative to information that was before the examiner.

[114] 37 CFR §1.56.

[115] [Doyle *Eolas v. Microsoft* trial testimony 509:10-13 (stating that he was generally involved in the prosecution of the patent); see Krueger Deposition Testimony of June 14, 2011 at 34:9-35:10 (drafting process was "back and forth" between Krueger and Doyle), 46:18-47:1 (Doyle supplied technical knowledge for prosecution); see also the various interviews and expert declarations Doyle submitted throughout the prosecution of both the '906 and '985 patent]

179. I have reviewed the testimony of Mr. Krueger given on June 14, 2011. Mr. Krueger testified that he received a fax on August 4, 1998 that included information regarding the ViolaWWW browser (the Viola Stuff folder).[116] The fax included emails from Mr. Pei Wei to Mr. Doyle regarding the demonstration of the ViolaWWW browser in 1993. The fax also included information regarding the Stanford Workshop presentation.[117]

180. Mr. Krueger further testified that a telephonic meeting occurred after he reviewed the ViolaWWW information. He does not remember if Mr. Doyle participated in the telephonic meeting. The outcome of Mr. Krueger's review of the ViolaWWW information after the meeting was a decision not to submit the ViolaWWW information to the PTO during the prosecution of the '906 patent. Mr. Krueger's explanation for not submitting the information was that he determined it was not prior art. [118] When further questioned why he did not consider the information prior art Mr. Krueger testified that he looked at the dates of the emails and determined that they were not prior art. [119] He further testified that he did not submit ViolaWWW information because it was "just a hearsay statement by someone claiming they'd done something."[120]

[116] Krueger deposition testimony of June 14, 2011 at 58: 23-59:3.

[117] Krueger deposition testimony of August 2, 2000 at 216:19-232:16 and deposition exhibits 278 and 279.

[118] Krueger deposition of June 14, 2011 at 59:7-60:23.

[119] Krueger deposition of June 14, 2011 at 184:5-9.

[120] Krueger deposition of June 14, 2011 at 185:6-12.

181. Mr. Doyle admitted that he sent the ViolaWWW information to Mr. Krueger in May 1998 for his review.[121]

182. The information contained in the Pei Wei emails and other information in the Viola stuff folder indicated that the ViolaWWW browser was publicly demonstrated in May and July of 1993. Mr. Krueger testified that he did no investigation or made no inquiry regarding this possible bar to patentability of the '906 patent but merely concluded that the emails themselves were not prior art because to the date of the emails which was after the critical §102 (b) statutory bar date.

183. Mr. Krueger improperly failed to evaluate the *content* of the Pei Wei emails and focused only on the dates of the emails themselves. He also considered the email information hearsay. A registered patent attorney would understand that these emails themselves did not constitute prior art, but the *content* of the emails in which Mr. Wei stated that he had earlier invented the ViolaWWW browser and it was publicly demonstrated more than one year prior to the filing date of the '906 patent was material information. Further, third party information including publications are not excluded as prior art because they are hearsay. Once put on notice or given information that a possible § 102 statutory bar to patentability may have existed, Mr. Krueger was under an obligation to make a reasonable inquiry into the prior invention and public use of ViolaWWW and disclose material information regarding the prior invention and public use of ViolaWWW to the PTO under his duty of disclosure.

184. The Federal Circuit held a patent unenforceable in *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp and Stryker Corp.*,267 F. 3d 1370 (Fed. Cir. 2001) deciding

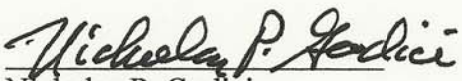
[121] Doyle deposition of June 30, 2011 at 230-231.

that an attorney has a duty of reasonable inquiry once put on notice of a potential on-sale bar. In this case Mr. Krueger was put on notice of a potential prior invention and public use when given the ViolaWWW information that included the Pei Wei emails. Mr. Krueger failed to do any inquiry or investigation and merely concluded that emails themselves were not prior art and decided not to inform the PTO of this prior invention by another and public use bar. This information was "but-for" material as explained above.

185. In my opinion Mr. Krueger violated his duty of disclosure by not conducting a reasonable inquiry into the § 102 statutory bar information he was given and by not disclosing the material prior invention of ViolaWWW and its public use and prior invention to the PTO during the prosecution of the '906 patent.

Respectfully submitted,

Date: July 20, 2011



Nicholas P. Godici

Exhibit A

Nicholas P. Godici
Executive Advisor
Birch, Stewart, Kolasch, & Birch, LLP

Professional Experience

Birch, Stewart, Kolasch & Birch, LLP, Falls Church, VA.

Executive Advisor (April 2005-present)
Responsibilities include business development, public relations, expert witness, and IP consulting.

United States Patent and Trademark Office, Department of Commerce, Washington D.C.

Commissioner for Patents (March 2000-March 2005)
Appointed by the Secretary of Commerce to a five-year term as Commissioner for Patents in 2000. Direct report to the Under Secretary Of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. Served as the Chief Operating Officer for all aspects of patent related operations with the mission to properly implement the patent laws and regulations of the United States. Oversaw a budget of over $750 million dollars and a staff of over 5000 employees. Areas of responsibility included strategic planning, budget formulation and execution, information technology systems, staffing, employee development, labor management relations, customer outreach, congressional relations, public advisory committee relations, and patent policy formulation. Testified before the United States House and Senate on various intellectual property matters.

Acting Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (January 2001-December 2001)
Served as Acting Under Secretary during the change in Administration in 2001. As the head of the Agency, chief executive officer and a direct report to the Secretary of Commerce, was responsible for all aspects of intellectual property policy and operations for the Administration. Represented the United States in international meetings at the World Intellectual Property Organization (WIPO) and with other national IP offices. Lead the "heads of office" meeting with the President of the European Patent Organization (EPO) and the Commissioner of the Japan Patent Office (JPO). Interacted with Congress, other agencies within the Administration, and major IP bar and trade associations on legal issues, operations of the USPTO, and national security.

Expert Advisor at the USPTO (July-September 2009)
At the request of the Secretary of Commerce I accepted a temporary assignment as an expert advisor to the Secretary and the Under Secretary of Commerce to strengthen the management structure of the USPTO and provide an up-to-date assessment of the challenges facing the agency.

Various Positions Within the USPTO (June 1972-March 2000)
Held various positions with the USPTO starting with patent examiner in the mechanical arts, Supervisory Patent Examiner, Group Director, Deputy Assistant Commissioner for Patents, and Acting Assistant Commissioner for Patents. Lectured in the Patent Academy for many years. Responsibilities included oversight for Patent Cooperation Treaty (PCT) operations which included the processing of all international applications. Assumed responsibility for the entire patent examining corps as Deputy Assistant Commissioner for Patents in 1997.

Education

B.S., Pennsylvania State University, Engineering Mechanics, 1972

Certificate of Advanced Public Management, The Maxwell School of Citizenship and Public Affairs, Syracuse University, 1999.

Professional Affiliations and Awards

Elected fellow of the National Academy of Public Administration (NAPA) 2001.

Outstanding Engineering Alumni, Pennsylvania State University, 2002

Member of the Industrial and Professional Advisory Committee for the College of Engineering at Pennsylvania State University.2001-2003.

Named “One of the most important people in intellectual property today” by Legal Times Magazine in 2001.

Registered to Practice before the United States Patent and Trademark Office

Publications

“Supporting a Knowledge Based Economy, Software Patents”, Managing Intellectual Property Magazine, Innovation and Invention Focus 2004.

“Adequately Funding the USPTO: A Critical Problem that Must be Solved”, Medical Innovation & Business, Summer 2010-Volume 2- Issue 2

Exhibit B

List of Cases in Which Nicholas P. Godici Has Served as an Expert Witness and Given Testimony (either at deposition or trial) Within the Last Four Years

ConnecTel LLC v Cisco Systems, Inc., United States District Court for the Eastern District of Texas, Civil Action 2:24-cv-00396-LED

Certain Flash Memory Devices and Components Thereof, and Products Containing Such Devices and Components, United States International Trade Commission, Investigation No. 337-TA-552 (Hynix v Toshiba)

Forgent Networks, Inc. v EchoStar Technologies, Inc., Scientific-Atlanta, Inc, Motorola, Inc., and Digeo, Inc., United States District Court For The Eastern District Of Texas, Consolidated Civil Action No. 6:06-cv-208

New York University v AutoDesk, Inc., United States District Court For The Southern District Of New York, Civil Action No. 06-cv-5274 (JSR) (MHD)

Trading Technologies Int'l, Inc. v eSpeed, Inc., eSpeed International, Ltd., Ecco LLC, and EccoWare, Ltd, United States District Court For The Northern District of Illinois, Civil Action 2:06-CV-156

American Calcar, Inc. v American Honda Motor Co., Inc. and Honda Of America Mfg., Inc., United States District Court for the Southern District of California, Civil No. 06-2433-DMS (CAB)

Lazare Kaplan International Inc. v Photoscribe Technologies, Inc. et al., United States District Court for the Southern District of New York, Civil Action No. 06-4005 (TPG) (GWG)

Repligen Corporation and the Regents of the University of Michigan, v Bristol-Myers Squibb Company, United States District Court for the Eastern District of Texas, Case No. 2:06-CV-004-TJW

Net2Phone, Inc., v eBay, Inc., Skype Technologies SA, Skype Inc., and John Does 1-10, United States District Court District of New Jersey, Civil Action No. 06-2469 (KSH)

In re K-Dur Antitrust Litigation, United States District Court District of New Jersey, Civil Action No. 01-1652 (JAG)

Bally Gaming, Inc. v IGT and Sierra Design Group, United States District Court for the District of Nevada, Case No. 3:06-CV-00483-Erc-(RAM)

Cross Atlantic Capital Partners Inc. v Facebook, Inc., United States District Court for the Eastern District of Pennsylvania, CA No. 07-CV-02768-JP

PDL Biopharma Inc. v SUN Pharmaceuticals Industries, United States District Court District of New Jersey, CA No. 07-1788 (KSH)(PS)

Medtronic Sofamor Danek v Globus Medical Inc., United States District Court for the Eastern District of Pennsylvania, CA No. 06-CV-4248-JG

Atlantic Research Marketing Systems, Inc. v Troy Industries, Inc., United States District Court for the District of Massachusetts, C.A. No. 07-cv-11576

DESA IP, LLC and HEATHCO, LLC v EML Technologies and Costco Wholesale Corp., United States District Court for the Middle District of Tennessee, Civil Action no. 3-04-0160

Certain Vein Harvesting Surgical Systems and Components Thereof, United States International Trade Commission, Investigation No. 337-TA-645, (Marquet v Terumo)

Degelman Industries LTD., v Pro-Tech Welding and Fabricating, Inc. and Michael P. Weagley, United States District Court Western District of New York, Civ. Action No.: 06-CV-6346

Conrad O. Gardner v. Toyota Motor Corp. et al., United States District Court Western District of Washington at Seattle, No. C 08-0632 RAJ

DataTreasury Corp. v. Wells Fargo & Co. et al, United States District Court for the Eastern District of Texas Marshall Division, case 2:06-cv-72DF

Semiconductor Energy Laboratory Co. v. Samsung Electronics Co. et al., United States District Court Western District of Wisconsin, civil action no. 3:09-cv-00001-BBC

Phillip M. Adams & Associates v. Fujitsu Limited et al., United States District Court for the Northern District of Utah, Civil No. 1:05-CV-64 TS

Software Tree LLC, v. Red Hat et al., United States District Court for the Eastern District of Texas, civil action no. 6:09-cv-00097

B.Braun Melsungen AG et al. v. Terumo Medical Corp. et al.,United States District Court for the District of Delaware, civil action no. 1:09-cv-00347

Ebay Inc. v. IDT Corp, IDT Telecom, Inc., Union Telecard Alliance LLC, and Net2phone, Inc., United States District Court Western District of Arkansas, civil action 4:08-cv-04015

The Chamberlain Group, Inc. and Johnson Controls Interiors LLC v. Lear Corporation, United States District Court for the Northern District of Illinois, civil action no. 05-C-3449

Kathrein-Werke KG, v. RYMSA, United States District Court Northern District of Illinois, 07 C 2921

SYNQOR Inc., v. Artesyn Technologies, Inc., United States District Court Eastern District of Texas, civil action no. 2:07-CV-497-TJW-CE

Joy MM Delaware Inc., v. Cincinnati Mine Machinery Co., United States District Court Western District of Pennsylvania, civil action no. 2:09-cv-01415- GLL

Halo Electronics, Inc., v. Pulse Engineering Inc., United States District Court District of Nevada, case no. 2:07-cv-00331-PMP-PAL

Wi-Lan, Inc. v. Acer et al, and Westell Technologies Inc .et al, United States District Court Eastern District of Texas, case no 2:07-cv-473-TJW and 2:07-cv-474-TJW

Mformation Technologies, Inc. v. Research In Motion Limited et al, United States District Court Northern District of California , case no. 08-cv-4990

Bedrock Computer Technologies LLC v. Softlayer Technologies et al, United States District Court Eastern District of Texas Tyler Division, Civil Action No. 6:09-cv-269-LED

US Rubber Recycling, Inc., v. ECORE International Inc., United States District Court Central District of California, Case No. CV 09-9516 SJO

* I served as an expert witness for the underlined party

Exhibit C
Materials Considered

PATENT INFORMATION:

5,838,906 Patent

7,599,985 Patent

5,838,906 Patent File Wrapper

'831 Patent File Re-Exam

'858 Patent File Re-Exam

7,599,985 Patent File Wrapper

PLEADINGS:

Plaintiff's Second Amended Complaint for Patent Infringement [Docket 517]

Defendant Yahoo! Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 561]

Defendant eBay Incorporated's Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 562]

Defendant Amazon.com, Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 563]

Eolas' Reply to Defendant Yahoo! Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 578]

Eolas' Reply to Defendant eBay Incorporated's Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 579]

Eolas' Reply to Defendant Amazon.com, Inc.'s Answer, Affirmative Defenses, and Counterclaims to the Second Amended Patent Infringement Complaint of Plaintiff Eolas Technologies Incorporated [Docket No. 580]

Defendant Microsoft's Local Rule 56.1(b)(3) Response to Plaintiffs' Statement of Undisputed Facts, and Microsoft's Statement of Additional Material Facts, in Opposition to Plaintiffs' Motion for Summary Judgment on Inequitable Conduct (with Exhibits) [EOLASTX-0000044448, EOLASTX-E-00000226121_HC-AEO]

Plaintiffs' Memorandum of Law in Support of Their Motion for Summary Judgment of Inequitable Conduct and Plaintiffs' Opposition to Defendant's Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 686]

Plaintiffs' Reply Brief in Support of Their Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 813]

Plaintiffs' Local Rule 56.1(a) Response to Defendant's Statement of Facts Regarding Plaintiffs' Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 822]

Plaintiffs' Statement of Undisputed Facts in Support of Their Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 685]

Plaintiffs' Motion for Summary Judgment [Eolas v. Microsoft, Docket No. 679]

Defendant Microsoft's Opposition to Plaintiffs' Motion for Summary Judgment on Inequitable Conduct [Eolas v. Microsoft, Docket No. 801]

Declaration of Richard A. Cederoth [Eolas v. Microsoft, Docket No. 800]

Defendant Microsoft's Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 670]

Plaintiffs' Memorandum of Law in Support of Their Motion for Summary Judgment on Inequitable Conduct and Plaintiffs' Opposition to Defendant's Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 686]

Defendant Microsoft's Reply Memorandum In Support of Its Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 691]

Plaintiffs' Sur-Reply Memorandum of Law in Opposition to Defendants' Motion for Leave to Amend Its Answer and Counterclaim [Eolas v. Microsoft, Docket No. 699]

Ruling on the Defense of Inequitable Conduct [Eolas v. Microsoft, Docket No. 491]

DEPOSITION TRANSCRIPTS:

Eolas v. Microsoft – Depositions of Michael Doyle [EOLASTX-E-0000000178, 180, 181, 182, 185, 186]

Eolas v. Microsoft – Depositions of Pei Wei

Eolas v. Microsoft – Deposition of Charles Krueger [EOLASTX-0000318685]

Deposition of Charles Kulas [6/15/2011]

Deposition Dr. Michael Doyle [6/24/2011]

Deposition Dr. Michael Doyle [6/30/2011]

Deposition of Charles Krueger [6/14/2011]

EOLAS PRODUCTION:

858 Re-exam [EOLASTX-0000003004-3806]

831 Re-exam [EOLASTX-0000004542-7068]

906 Patent Prosecution [EOLASTX-0000007069-8338]

985 Patent Prosecution [EOLASTX-0000008339-9072]

Subject: How to Reach Cheong Ang - Martha Leuhrmann email to Michael Doyle, 8/29/94 [Defendant's Trial Exhibit 825, EOLASTX-0000026094]

RE: Testing accounts for ViolaWWW – David Martin email to Pei Wei 5/20/94 [Defendant's Trial Exhibit 89, EOLASTX-0000025958-25959]

Index of Michael D. Doyle E-Mails [Defendant's Trial Exhibit 703B, EOLASTX-0000026059-26092]

Re: the <EMBED> tag in HTML+ - Michael Doyle message to David Martin 5/20/94 [Defendant's Trial Exhibit 90, EOLASTX-0000025961-25962]

7,599,985 Patent [EOLASTX-E-0002374729_HC-AEO]

Re: Eolas Acquires Milestone Internet Software Patent – Pei Wei 8/21/95 [Defendant's Trial Exhibit 135, EOLASTX-0000022474-22475]

Re: Viola.tar.z for ftping – Pei Wei email to James Kempf 5/31/1993 [Defendant's Trial Exhibit 41, EOLASTX-0000065008]

Re: ViolaWWW – Pei Wei message to weber@eit.com, wei@ora.com 10/17/93 [Defendant's Trial Exhibit 62, EOLASTX-0000022428]

Re: ViolaWWW alpha – John Cahill message to wei@xcf.berkeley.edu 10/21/93 [Defendant's Trial Exhibit 63, EOLASTX-0000022429]

Re: ViolaWWW beta release is available – Pei Wei posting 2/25/1994 [Defendant's Trial Exhibit 73, EOLASTX-0000022436-22437]

Viola Stuff [Defendant's Trial Exhibit 147, EOLASTX-00000168065-168090]

"A Brief Overview of the VIOLA Engine, and its Applications" [Defendant's Trial Exhibit 93A, EOLASTX-0000025964-25974]

Re: FYI…press release – Michael Doyle posting 8/31/94 [Defendant's Trial Exhibit 100, EOLASTX-0000168171]

FYI…press release – Michael Doyle posting 8/30/94 [Defendant's Trial Exhibit 826, EOLASTX-0000022772-22773]

Re: FYI…press release – Pei Wei message to www-vrml@wired.com 8/31/94 [Defendant's Trial Exhibit 98, EOLASTX-0000061841]

Re: FYI…press release – Michael Doyle message to Pei Wei 8/31/94 [Defendant's Trial Exhibit 99, EOLASTX-0000035966]

Re: FYI…press release – Michael Doyle posting 8/31/94 [Defendant's Trial Exhibit 101, EOLASTX-0000025980-25981]

Re: FYI…press release – Michael Doyle posting 8/31/94 [Defendant's Trial Exhibit 102, EOLASTX-0000043735-43736]

Re: FYI…press release – Pei Wei message to Michael Doyle 8/31/94 [Defendant's Trial Exhibit 107, EOLASTX-0000042939-42940]

Re: FYI…press release – Pei Wei posting 9/1/94 [Defendant's Trial Exhibit 111, EOLASTX-0000025989-25990]

Viola Information from Stanford Computer Forum WWW Workshop – September 20-21, 1994 [Defendant's Trial Exhibit 121, EOLASTX-0000168057-168063]

Viola Information from Stanford Computer Forum WWW Workshop – September 20-21, 1994 [Defendant's Trial Exhibit 122, EOLASTX-0000168154-168165]

Eolas Acquires Milestone Internet Software Patent – Info@eolas.com to www-talk@w3.org 8/21/95 [Defendant's Trial Exhibit 196, EOLASTX-0000026057]

Eolas Acquires Milestone Internet Software Patent – Pei Wei to www-talk@w3.org 8/21/95 [Defendant's Trial Exhibit 136, EOLASTX-0000026004]

Eolas Acquires Milestone Internet Software Patent – Pei Wei to Michael Doyle 8/21/95 [Defendant's Trial Exhibit 138, EOLASTX-0000026006]

Eolas v. Microsoft - Supplemental Expert Invalidity Report of John Kelly [EOLASTX-0000098503-98637]

The Virtual Embryo: VR Applications in Human Developmental Anatomy [EOLASTX-0000000273-276]

OTHER PRODUCTION:

RE: Hot Java is here! And it *rocks* - Michael Doyle message to ses@tipper.oit.unc.edu 3/27/95 [Defendant's Trial Exhibit 127, PH_001_0000597952]

Eolas v. Microsoft - Expert Invalidity Report of John Kelly [PH_001_0000035135-35184]

Portable Document Format Reference Manual [ADBE0195521]

TRIAL TRANSCRIPTS:

Eolas v. Microsoft Inequitable Conduct Hearing Transcript [EOLASTX-E-0000000631, 632, 633]

Eolas v. Microsoft Trial Transcript

OTHER DOCUMENTS:

Report by the National Academy of Public Administration, "U.S. Patent and Trademark Office: Transforming to Meet the Challenges of the 21st Century", August 2005

Claim Chart for Adobe Showing Indirect Infringement of the 906 Patent Through PDF Authoring Tools and Direct and/or Indirect Infringement Via Its PDF Viewers

Claim Chart for Adobe Showing Indirect Infringement of the 906 Patent Through Flash Authoring Tools and Direct and Indirect Infringement Via Players

Claim Chart for Adobe Showing Indirect Infringement of the 985 Patent Through PDF Authoring Tools and Direct and/or Indirect Infringement Via Its PDF Viewers

Claim Chart for Adobe Showing Indirect Infringement of the 985 Patent Through Flash Authoring Tools and Direct and Indirect Infringement Via Players

Adobe Systems Incorporated – Preferred Customer Agreement for Disclosures of Adobe Information between UCSF [8/19/93] [ADBE0195776]

Kevin Altis post Re: Adobe's PDF found at [http://www.intercom.co.cr/www-archives/1993-q3/0207.html] [7/19/93]

Email from John Dawes re: Acrobat and UCSF [5/17/93]

Email from Christopher McRae to www-talk re: HTML spec [6/21/93]

Email from Christopher McRae to David Martin re: Adobe Acrobat beta agreement? [6/2/93]

Email from Christopher McRae to John Dawes re: Acrobat and UCSF [5/14/93]

Email from David Martin to Christopher McRae re: Adobe Acrobat Beta Agreement? [6/21/93]

Email from David Martin to Daniel Miles Kehoe re: Adobe's PDF [7/20/93]

Email from David Martin to Marc Solomon re: [kehoe@fortuity.sf.ca.us (Daniel Miles Kehoe): Adobe's PDF] [7/19/93]

Webpage - An Overview of Hypertext and IR Systems and Applications
http://info.cern.ch/hypertext/products/overview.html

Image of Los Alamos National Laboratory CD – LANL – Software and Visualization Sampler

Email from Christopher McRae to David Martin re: More hypertext systems [9/8/93]

"Mediaview" posting found at:
[http://www.w3.org/History/19921103-hypertext/hypertext/Products/MediaView/Mail.html]

Email from Callilіau@cernnext.cern.ch to tim@cernnext.cern.ch, www-talk@nxoc01.cern.ch, luotonen@ re: WWWWorkshop [7/16/93]

Email from Daniel Miles Kehoe to cailliau@cernnext.cern.ch re: Adobe's PDF [7/16/93]

Email from Christopher McRae to David Martin re: Adobe Acrobat Beta Agreement? [6/18/93]

A Brief History of Adobe Acrobat [ADBE0196062-0196071]